137-408

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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1890.

No. 94.

SARAH MAY, PLAINTIFF IN ERROR,

vs.

THE COUNTY OF JUNEAU.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE WESTERN DISTRICT OF WISCONSIN.

FILED SEPTEMBER 2, 1887.

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1 UNITED STATES OF AMERICA, *ss:*

The President of the United States to the judges of the circuit court of the United States for the western district of Wisconsin, Greeting:

Because in the record and proceedings and also in the rendition of a judgment which is in the said circuit court, before you, between Sarah May, plaintiff, and Juneau County, defendant, a manifest error hath intervened to the said Sarah May, as by her complaint appears, we, being willing that the error, if any hath been, should be duly corrected and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you may have the same at Washington, in the District of Columbia, on the second Monday of October next, in the said Supreme Court to be then and there held, that, the record and proceedings afore-
2 said being inspected, the said Supreme Court may cause further to be done therein to correct that error what of right and according to the laws and customs of the United States should be done.

Seal U. S. Circuit Court, Western Dist. of Wisconsin.

Witness the Hon. Morrison R. Waite, Chief Justice of the Supreme Court of the United States, the 9th day of May, in the year of our Lord one thousand eight hundred and eighty-seven, and of our Independence the one hundred and eleventh.

F. M. STEWART,
Clerk U. S. Circuit Court, West'n District of Wisconsin.

The return of the judges of *of* the circuit court of the United States for the western district to the foregoing writ appears by the schedule hereto annexed.

Seal U. S. Circuit, Court, Western Dist. of Wis-
3 consin.

In testimony whereof I have hereunto set my hand and affixed the seal of the said circuit court, at Madison, in said district, this 9th day of May, A. D. 1887.

F. M. STEWART,
Clerk U. S. Circuit Court, West'n Dist. Wis.

4 [Endorsed:] U. S. Supreme Court. Sarah May, pl'ff in error, *vs.* Juneau County, def't in error. Writ of error.

5 UNITED STATES OF AMERICA, *Western District of Wisconsin,* } *ss:*

Be it remembered that heretofore, to wit, at a stated term of the circuit court of the United States for the western district of Wisconsin, begun and held according to law at the city of Madison, in

said district, on the first Tuesday, being the 7th day, of December, A. D. 1886—present and presiding, the Hon. Romanzo Bunn, judge—and on the — day of said term, to wit, the 11th day of February, A. D. 1887, the following proceedings were had, to wit:

SARAH MAY, Plaintiff,
vs.
THE COUNTY OF JUNEAU, Defendant.

Be it remembered that heretofore, to wit, on the 19th day of September, A. D. 1885, came the above-named plaintiff, by her attorneys, and filed her complaint herein as follows:

Complaint.

6 UNITED STATES OF AMERICA:

The Circuit Court of the United States of America for the Western District of Wisconsin.

SARAH MAY
vs.
THE COUNTY OF JUNEAU.

The plaintiff, Sarah May, complains of the defendant, The County of Juneau, and alleges that she is a citizen and resident of the State of Illinois, and that the defendant is a corporation within the State of Wisconsin and a citizen of said State and of the western district thereof.

And the plaintiff alleges that Edwin May, of the city of Indianapolis, in the State of Indiana, was before and at the time of his application for the hereinafter-mentioned letters patent a citizen of the United States and was the true, original, first, and only inventor of a certain new and useful apparatus described in the specifications of the letters patent hereinafter mentioned and named therein—"improvements in the construction of prisons"—and which was not known or used in this country and not patented or described in any written or printed publication in this or any foreign country before his invention thereof and was not in public use or on sale more than two years prior to his application for letters patent of the United States therefor; that heretofore, to wit, on the 4th day
7 of October, A. D. 1859, letters patent for said invention in due form of law were, on the application of the said Edwin May, issued and delivered to the said Edwin May in the name of the United States of America, numbered 25662, and under the seal of the Patent Office of the United States, and were signed by the Secretary of the Interior of the United States and countersigned by the Commissioner of Patents; that the said letters patent did grant unto the said Edwin May, his heirs and assigns, for the term of fourteen years the exclusive right to make, use, and vend the said invention throughout the United States and the territories thereof; that afterwards and before the 4th day of October, A. D. 1873, the said Edwin May did file his petition in the Patent Office for the exten-

sion of the said patent for the period of seven years from and after the date last named, and, having complied with the statute in such case made and provided, the Commissioner of Patents, pursuant to law and in accordance with the statutes of the United States in such case made and provided and then in force, did, on the said 4th day of October, 1873, extend the said patent for the term of seven years from and after the said 4th day of October, 1873, and did attach to said original letters patent his, the said Commissioner's, certificate, duly signed by him, bearing date said 4th day of October, 1873, as

8 by said letters patent or a duly certified copy thereof and as by said extension certificate or a duly certified copy thereof more fully appears and which plaintiff will present in court in connection with this complaint and in explanation thereof.

That said extended letters patent did grant unto said Edwin May, his heirs or assigns, for the term of seven years from and after the said 4th day of October, 1873, the exclusive right to make, use, and vend the said invention throughout the United States and the territories thereof.

That on or about the 27th day of February, A. D. 1880, the said Edwin May died in the county of Marion, in the State of Indiana, testate, being at the time of his death the sole owner of said letters patent and the extension thereof and all rights thereunder, both at law and in equity, and being then a resident of said county of Marion; that afterwards and on the 6th day of March, A. D. 1880, one Edwin Forrest May was, by the circuit court of the said county of Marion, in said State of Indiana, that being the court having jurisdiction of the estates of deceased persons, duly appointed executor of the last will and testament of said Edwin May, deceased, and thereupon duly qualified and entered upon the duties of his trust.

That afterwards and on the 7th day of June, 1880, the said Edwin

9 Forrest May having resigned his trust as such executor and his resignation having been accepted by said court, the said court did, on the day last aforesaid, duly appoint Geo. T. McGinnis administrator *de bonis non*, with the will annexed, of all and singular the goods, chattels, credits, and effects of said Edwin May, deceased, as by the letters of administration or a duly certified copy thereof will more fully appear.

That the said administrator, George T. McGinnis, did, on the 30th day of Dec., 1880, procure from said Marion county circuit court an order, in due form of law, authorizing and directing him as such administrator to sell all the right, title, and interest, claim and demand of said estate in, by, under, and through said letters patent and the extension thereof, and that pursuant to said order said administrator did, on or about the 6th day of March, A. D. 1882, sell, transfer, and convey to said plaintiff all the right, title, claim, and demand of said estate of said deceased, including all rights of action and claims for damages of every description and kind, which said estate had by reason of said patent and said extension, which said transfer and the instrument of conveyance were duly approved and confirmed by said court, and to which instrument and order of ap-

proval plaintiff refers and offers to produce the same or certified copies thereof.

10 And the plaintiff says she is now the sole owner of said patent and of the extension thereof and of all rights thereunder, including all rights of action, both at law and in equity, to recover profits and damages for infringement; and the plaintiff further says that always hitherto, from the time of the issuing of said original patent, the owner thereof vended to others the right to make and use specimens of said invention, to the great advantage and profit of said owner.

The plaintiff further alleges that the defendant is a corporation duly and legally organized, established, and constituted under the laws of the State of Wisconsin, being one of the counties of said State, located within said western district of Wisconsin.

That the defendant, well knowing the premises, but contriving to injure the plaintiff, heretofore, to wit, on the 4th day of October, 1876, and up to and including the 4th day of October, 1880, and within and during the term of seven years mentioned in the said certificate of extension, and after the granting of said letters patent and said extension, and before the bringing of this suit, and within the district aforesaid, unlawfully, wrongfully, and injuriously and with intent to deprive the plaintiff and her assignor of the royalties which she and her said assignor might and otherwise would

11 have derived from the sale of rights to make and use specimens of the apparatus covered by said letters patent and extension thereof, without license of the plaintiff or any other person authorized to grant license, and against the title of the plaintiff and her assignor, did make and use and cause to be made and to be used sundry specimens of said apparatus and of machines which contained and employed substantially the invention covered by said letters patent, in infringement of said exclusive rights secured as aforesaid to said Edwin May by the letters patent aforesaid and the extension thereof and granted by said administrator or to the said plaintiff, as hereinbefore set forth, and contrary to the statute of the United States in such case made and provided, whereby the plaintiff has been deprived of the reasonable royalty upon the infringeing apparatus so used and caused to be used by the defendant, and of large royalties which she might and otherwise would have derived from the sale of rights to make and use specimens of said apparatus, and has sustained actual damage thereby to the extent of one thousand dollars.

Wherefore, by force of the statutes of the United States, a right of action has accrued to the plaintiff to recover the said actual damages and such additional amount, not exceeding in the

12 whole three times the amount of such actual damages, as the court may see fit to adjudge and award, besides costs.

That the defendant, though often requested, has not paid said damages nor any part thereof, but has refused and still refuses to do so.

Wherefore the plaintiff demands judgment against the defendant for said damages with costs of suit.

G. W. HAZELTON,
Pl'tff's Att'y.

Whereupon a summons issued; which said summons, with the return of the marshal duly endorsed thereon, is in words & figures following, to wit:

13 [Endorsed:] No. 122 B. W. dist. of Wisconsin. In the U. S. circuit court. Sarah May, pl't'ff, *vs.* The County of Juneau, def't. Sum. and complaint. Filed Sept. 19, 1885. F. M. Stewart, cl'k. G. W. Hazelton, pl't'ff's att'y.

Summons & Return.

14 Circuit Court of the United States for the Western District of Wisconsin.

SARAH MAY, plaintiff,
vs.
THE COUNTY OF JUNEAU.

The President of the United States of America to the said defendant:

You are hereby summoned to appear within twenty days after service of this summons, exclusive of the day of service, and defend the above-entitled action in the court aforesaid; and in case of your failure so to do judgment will be rendered against you according to the demand of the complaint, which is filed in the office of the clerk of this court, at Madison, Wisconsin, & copy of which is herewith served on you.

And you are also required to file your answer in said action in the office of the clerk of this court, at the city of Madison, within the time above specified.

The marshal*l* of said district is hereby commanded to serve this summons and make due return thereto.

Witness the Hon. Morrison R. Waite, Chief Justice of the
15 Supreme Court of the United States, at the city of Madison, in the said western district of Wisconsin, this 19th day of September, in the year of our Lord one thousand eight hundred and eighty-five, and of the Independence of the United States the one hundred and 10th.

[SEAL.] F. M. STEWART, *Clerk.*

G. W. HAZELTON,
Plaintiff's Attorney.

P. O. address, Milwaukee, Wis.

[Endorsed:] No. 122 B, law docket. Sarah May *vs.* The County of Juneau. Summons and complaint. Filed Sept. 26, 1885.

Served on the within-named County of Juneau by showing C. F. Cutler, county clerk thereof, this summons and complaint and by delivering to him personally a copy thereof this 23rd day of September, A. D. 1885. Served on the within-named —— —— by leaving a copy of this summons and complaint at his usual place of

abode, in presence of a member of his family of suitable age and discretion, whom I informed of the contents thereof, he not being found, this — day of ——, A. D. 18—.

F. W. OAKLEY, *Marshal*,
By —— ——, *Deputy*.

Fees:

Service	2 00
Copies	1 80
Travel	4 56
	8 36

16 Whereupon the said defendant duly appeared and thereafter and on the 28th day of October, A. D. 1885, filed its demurrer thereto as follows, viz:

Demurrer.

17 UNITED STATES OF AMERICA:

The Circuit Court of the United States of America for the Western District of Wisconsin.

SARAH MAY, Plaintiff,
vs.
THE COUNTY OF JUNEAU, Defendant.

Now comes the defendant, The County of Juneau, by J. J. Hughes, its attorney, and demurs to the complaint herein for and upon the ground that it appears upon the face of the complaint—

That the complaint does not state facts sufficient to constitute a cause of action.

Dated October 27th, 1885.

J. J. HUGHES,
Defendant's Attorney.

P. O. address: New Lisbon, Wis.

And in the record of proceedings aforesaid in said entitled cause thereafter and at a term of said court held as aforesaid and on the 9th day of July, A. D. 1886, there appears the following entry, to wit:

Order Overruling Demurrer.

18 SARAH MAY, Plaintiff,
vs.
THE COUNTY OF JUNEAU, Defendant.

This day came the parties hereto, by their attorneys, and the demurrer of the defendant to the complaint of the plaintiff came on to be heard and was argued by counsel. Now, therefore, on consideration thereof, it is ordered that said demurrer be, and the same is hereby, overruled *pro forma*, and the questions raised by said demurrer are reserved for final hearing.

And thereafter, to wit, on the 28th day of July, A. D. 1886, came the defendant, by its attorney, and filed its answer herein as follows:

Answer.

Circuit Court of the United States for the Western District of Wisconsin.

SARAH MAY, Plaintiff,
vs.
JUNEAU COUNTY, Defendant.

And the said defendant, by J. J. Hughes, its attorney, comes and defends the wrong and injury when, etc., and says that it is not guilty of the supposed grievances above laid to its charge, or any or either of them or any part thereof, in manner and form as the said plaintiff has above thereof complained against it; and of this the defendant puts itself upon the country.

And, for a further plea in this behalf, the said defendant says that the said plaintiff ought not to have or maintain her aforesaid action thereof against it, because it says that the said several supposed causes of action in the said declaration mentioned did not nor did any or either of them accrue at any time within six years next before the commencement of this suit in manner and form as the said plaintiff hath above thereof complained against it, the said defendant; and this the defendant is ready to verify.

And, for a further plea in this behalf, that said defendant says that the said plaintiff ought not to have or maintain her
20 aforesaid action against it, because it says that it is a *quasi* corporation existing under and by virtue of the laws of the State of Wisconsin for public purposes, and that, among the public functions which it is by law charged whith the duty of exercising, the statutes of the State of Wisconsin direct that all of the counties of said State shall provide and maintain at the county-seat a county jail, and that in pursuance of such duty so charged upon it the defendant, on or about the 21st day of June, A. D. 1878, entered into a written contract with Thomas P. Cameron, W. A. Sykes, and A. E. Sykes, of Manston, Wisconsin, for the building of a county jail at said Manston, being the county-seat of this defendant, in and by which it was agreed that the said Cameron and Sykes should build and construct all the stone, brick, wood, iron, and other parts of and for a brick building designed for a county jail and jailor's residence, and furnish all necessary materials for the same, in accordance with plans and specifications for said building, which were made a part of said contract, on or before the 15th day of October, A. D. 1878, for the sum of ten thousand nine hundred dollars, to be paid therefor by this defendant; that in and by the specifications accompanying said contract and so made a part thereof it was provided as follows:

21 "On all cell and corridor doors place a lock plate of ¼-inch boiler plate, rivetted as shown. On this plate fasten the lock with two heavy staples, and a similar staple on door frame for lock

bolt. The locks to bath-room doors fastened in same manner. All these locks to be a heavy iron case, three tumbler-, and heavy bolt. The cell doors are further locked by a wrought-iron shut-bar working on two staples for each door, and with an additional staple on door frame and door style, all these staples to have steel rollers. The back end of shut-bar enlarged to prevent it from passing through staples. These bars on lower tier of cells to extend to outside face of corridor enclosure, with ¾ inch thick bolts rivetted on the face to secure bar handle, the handle to be in form of a lever, secured on bottom with Scandinavian lock. The shut or lock bar for upper — of cells made and secured on the same — to cell fronts, and to extend through the wall into the hallway and turnkey room, with a plate anchored to wall and with same kind and quality lock for handle."

That said specifications did not contain any other or further provision as to the construction of locks for said cells, nor did the said contract, and the plans for said cell door and lock were in conformity with said specifications, except that said plans did
22 not show any extension of said shut-bar outside of the corridor enclosure on the lower floor or into the hallway or turnkey's room on the upper floor; that shortly after the said contract was so entered into as aforesaid the said contractors, Cameron and Sykes, hereinbefore named, subcontracted all of the iron-work which they had so agreed to perform, including all the locks for said jail and for all the doors thereof, to one Theda Carter, of Manston aforesaid, and made and entered into a contract with her for that purpose; and the said Theda Carter, during and in the performance of her said contract, caused to be made and constructed and put into said jail, in or about the month of January, 1879, levers, shut-bars, and locks, substantially as described in the specifications therefor hereinbefore mentioned, without any license so to do by the said Edwin May and without any authority from this defendant so to do; that the aforesaid act of the said Theda Carter constitutes the alleged infringement of the patent of the said Edwin May complained of in and by the said declaration mentioned, and this defendant is in no way or manner liable therefor; and this the defendant is ready to verify.

And, for a further plea in this behalf, the defendant says that the matter covered by said original letters patent, especially the
23 fourth claim thereof, was not a statutory subject of a patent for that it is a principle and not a process or the application of a principle; and this it is ready to verify.

Wherefore the defendant prays judgment if the said plaintiff ought to have or maintain her aforesaid action against it.

J. J. HUGHES,
Att'y for Defendant.

[Endorsed:] No. 122 B. U. S. circuit court, west. dist. of Wisconsin. Saray May *vs.* Juneau County. Answer. Filed July 28, 1866. F. M. Stewart, cl'k. J. J. Hughes, def't's att'y.

And come the parties, by their attorneys, and filed their stipulation as follows, viz:

Stipulation.

24 WESTERN DIST. OF WIS.:

In U. S. Circuit Court.

SARAH MAY
vs.
JUNEAU COUNTY.

It is hereby stipulated and agreed that prior to Oct. 4, 1859, a device or contrivance was in use in the State prison, at Waupun, Wisconsin, and elsewhere, for fastening a series or row of cell doors by means of a lever and horizontal bar, but not operated outside of a corridor or partition separating the prisoners from the jailer. The object of this stipulation is to avoid the necessity of introducing on the trial of this action any evidence of the exact or particular contrivance in use in Waupun and elsewhere prior to the patent of the plaintiff.

Dated Dec. 22, 1886.

G. W. HAZELTON,
Pl'ff's Att'y.
J. J. HUGHES,
Def't's Att'y.

25 And also came the parties hereto and filed stipulation as to proof as follows, viz:

Stipulation as to Proofs.

26 Circuit Court of the United States for the Western District of Wisconsin.

SARAH MAY, Plaintiff,
vs.
JUNEAU COUNTY, Def't.

It is hereby stipulated and agreed, in lieu of the oral testimony of Charles F. Cutler to be given on the trial of this action, that the said Cutler will testify in substance that he has been clerk of the county board of supervisors of the defendant county and county clerk of said county ever since the county was organized; that he was such county clerk when the public jail of said county was built and from the time of the passage of the resolution therefor by the county board until the same was completed; that he knew or heard until on or about the 21st day of July, A. D. 1885, that there had been put into the said jail a lock substantially the same as the patent claimed by the plaintiff in this action, or that there was any patent on the lock or locks in use in said jail, or that the same infringed any patent, or that it was claimed or asserted by any person that any such infringe-

ment existed; that he was informed in a letter from G. W. Hazelton, Esq., attorney for the plaintiff, in said letter of July 21, 1885, that he, the said Hazelton, was informed that the defendant was
27 using the May patent in its jail to secure the doors of the cells; that he will further testify that the fact of the use of said patent or any patent, or that any infringement was claimed or asserted by or on the part of said county or its officers or servants in its jail, was never brought before the county board of supervisors of the defendant county in or by any resolution, motion, or in any other way until the session of said board in November, A. D. 1866; that said Cutler will further testify that said jail was first occupied and used by the county or its officers on or about the first day of January, A. D. 1879. This stipulation may be used upon the trial in the same manner as if the said Cutler had testified to the same matters on the trial of this action, subject to any objection on the ground that the same or any part thereof is incompetent or immaterial.

It is further agreed that the records of the county board of supervisors in relation to the building and acceptance of said jail, so far as material, may be offered and used in evidence without being first produced or identified by said Cutler, and that the original contract for the construction of said jail, dated June 21, 1878, between said county and Thomas P. Cameron, Wilber A. Sykes, and Eugene Sykes, and signed by them and by John Turner, T. P.
28 Naughtin, and J. W. Tarbox, building committee of said county, may be offered and used in evidence, subject to objection as immaterial without being produced or identified by said Cutler.

Dated January 4, 1887.

G. W. HAZELTON,
Attorney for Plaintiff.
J. J. HUGHES,
Attorney for Defendant.

[Endorsed:] May *vs.* Juneau county. Stipulation as to proof. Ex. 7.

And in the record of proceedings aforesaid in said entitled cause appears the following entry, under date of the 10th day of February, A. D. 1887, viz:

Trial.

SARAH MAY, Plaintiff,
vs.
THE COUNTY OF JUNEAU, Defendant.

This day came the parties, and this cause came on to be tried; whereupon a jury is ordered to come, who came, to wit: J. N.
29 Jones, D. K. Noyes, William Vroman, W. W. Pollard, B. Warnes, A. H. Hallister, Frank Proudfit, Wm. McConnell, J. T. Bruce, Dayton Locke, H. C. Goodenough, & C. F. Cooley, twelve

honest and lawful men of the district, duly empanneled, tried, and sworn, and the trial commenced.

And thereafter, in the said record of proceedings aforesaid, appears the following entry, to wit:

Judgment.

SARAH MAY, Plaintiff,
vs.
THE COUNTY OF JUNEAU, Defendant.

This day came the parties, by their attorneys. The trial is concluded, and the jury, being instructed in the law by the court, upon their oaths do say that they find for the defendant herein under the direction of the court.

30 Whereupon it is considered and adjudged by the court now here that the said defendant do have and recover of the said plaintiff, Sarah May, the sum of one hundred seventy-five dollars and ninety-six cents, for its costs in this behalf by it expended, and that it have execution therefor.

Judgment-roll signed February 11th, A. D. 1887.
Costs, $175.96.

F. M. STEWART, *Clerk.*

And thereafter and on the 17th day of February, A. D. 1887, came said plaintiff and filed motion to vacate & set aside order directing a verdict herein, as follows:

Motion to Vacate.

31 WESTERN DIST. OF WISCONSIN:

In the U. S. Circuit Court.

SARAH MAY
v.
JUNEAU COUNTY.

And now comes the plaintiff and moves the court to vacate and set aside the order entered herein on the 11th day of February, 1887, directing the jury to return a verdict for the defendant and to grant a new trial of the action, on the following grounds:

1. That the said order was and is erroneous and unwarranted in law.

2. That the cause ought to have been submitted to the jury for its decision on the questions of fact involved therein.

3. That the court erred in holding as a matter of law that the plaintiff had no right to bring and maintain the action.

4. That the court erred in holding that the action could not be maintained against a county.

G. W HAZELTON,
Pl'tf's Att'y.

32 Whereupon the court made the following order, to wit:

Order Overruling Motion.

33 SARAH MAY, Plaintiff,
vs.
THE COUNTY OF JUNEAU, Defendant.

The motion of the plaintiff to vacate and set aside the order directing a verdict herein on the trial of this cause coming on to be heard, and the court being sufficiently advised in regard thereto, it is—

Ordered, That such motion be, and the same is hereby, overruled.

And came the parties and filed their stipulation herein regarding bill of exceptions, as follows:

Stipulation.

34 In the United States Circuit Court, Western District of Wisconsin.

SARAH MAY
v.
THE COUNTY OF JUNEAU.

It is stipulated that the plaintiff have thirty days from this date in which to serve a proposed bill of exceptions in the above-entitled cause, and that the defendant have the same time after the same is served as is allowed by statute for serving proposed amendments thereto, and that sufficient time be allowed thereafter for the judge to settle the said bill.

G. W. HAZELTON,
Att'y for Pl'tff.
J. J. HUGHES,
Def't's Att'y.

Dated April 2nd, 1887.

And came the parties and filed their bill of exceptions as follows:

Bill of Exceptions.

35 U. S. District Court, W. D. of Wisconsin.

SARAH MAY
v.
THE COUNTY OF JUNEAU.

Be it remembered that on the 10th day of February, at a special term *term* of said court, in and for said district, begun and held on the first Tuesday of December, 1886, and holden at the U. S. court-

room, in the city of Madison, in said district, this action came on to be tried before the Honorable Romanzo Bunn, district judge of said district, and a jury duly empaneled to try the same.

The plaintiff appeared by G. W. Hazelton, her attorney, and M. C. Burch, Esq., of counsel, and the defendant by its district attorney, F. S. Veeder, Esq., and A. L. Sanborn, Esq., of counsel.

And thereupon the following proceedings were had: The plaintiff to sustain the issue on her part offered in evidence the letters patent of the United States to Edwin May, dated October 4, 1859, numbered 25662, which are pleaded in her complaint; said letters patent, with specification and claim, were read in evidence and marked Ex. A, and a true copy thereof is hereto annexed.

36 The certificate of the Commissioner of Patents for an extension of said patent from October 4, 1873, to October 4, 1880, dated October 4, 1873, was then offered in evidence by the plaintiff and received and read and marked Ex. B, a true copy of which is hereto annexed.

The plaintiff then offered successively and in connection with each other the following documents:

A certified copy of the proceedings for letters testamentary issued out of the circuit court of Marion county, Indiana, to Edwin Forrest May as executor of the last will and testament of Edwin May, deceased, dated March 6, 1880.

A certified copy of the resignation of said Edwin Forrest May as such executor, dated June 7, 1880, and of the order of the court accepting the same.

A certified copy of the letters of administration *de bonis non* with the will annexed, issued out of the circuit court for Marion county, Indiana, to George F. McGinnis as administrator *de bonis non*, dated June 7, 1880, and of his bond as such administrator.

A certified copy of the petition of Geo. F. McGinnis to said circuit court for Marion county, Indiana, for authority to said administrator *de bonis non* to make sale of said letters patent No. 25662, dated December 31, 1881.

A certified copy of the order of the circuit court for Marion county, Indiana, to said George F. McGinnis as such administrator

37 *de bonis non* upon said petition, dated December 31, 1881.

A certified copy from the Patent Office of the deed or instrument of conveyance made upon such sale by said administrator *de bonis non* to the plaintiff, dated March 7, 1882.

A certified copy of said administrator's report of sale and deed and of the order of said circuit court for Marion county, Indiana, confirming said sale and deed, dated March 7, 1882; to each of which several documents the defendant objected that *day* were singly or collectively immaterial and incompetent and did not vest any title to the cause of action sued on in the plaintiff, and that the jurisdiction of the court wherein said proceedings were had is not shown.

The objections were overruled and said documents were admitted and read in evidence in the order stated and marked successively as Exhibits C, D, E, F, G, I, H.

To which ruling upon each of said documents the defendant then severally excepted.

The plaintiff then called as a witness in her behalf LUTHER V. MOULTON, who, being sworn, testified:

I live at Grand Rapids, Michigan; am a partner in a foundry there. I have had experience in mechanics and patents; have photographed models; have been consulted about the patentability of mechanical devices; have been an expert witness in patent
38 causes; have done patent soliciting; have examined and am acquainted with the May patent in suit; know its specifications and claims and am acquainted with its practical operation and effect. I have examined the jail of the defendant county and the cells therein and the device there in use for fastening the doors of the cells, its arrangement and method of operation. Such device contains, in my opinion, the mechanical equivalent of the so-called May patent. It is substantially the same thing as the device described in the specifications and claims of the patent in question, except the second and third claims.

The results produced by the combinations claimed in the patent, so far as they relate to the first and fourth claims, are produced in the jail by substantially the same means.

A model of the May patent was here shown the witness and put in evidence and marked Ex. X.

The witness explained the method of operating the device by reference to the model and pointed out the similarity between the device used by defendant and that of the model.

On cross-examination the witness testified:

The novelty and utility of this patented device consists in interposing a grating or wall between the person operating the mechanism for securing the doors and the prisoners, so that they can
39 be observed through the door or point of observation and the corridor doors be closed and secured or unlocked and opened or the cell doors locked or unlocked, all without contact between —, the jailor being in the same apartment with the prisoners, and thus exposed to attack by them.

The several elements of the device are probably old. The novelty consists in the particular combinations whereby a new and useful result is produced.

I think an angle door is old; have never seen them in jails; have seen angle doors and curved doors and illustrations of them in books many years ago—before 1859. Locks and bolts upon doors are also sold, and to put a lock or bolt on a door would not be novelty or invention.

The operation and effect of the lever in moving the device which locks and unlocks the cell doors are precisely the same without or with a wall or grating interposed between the lever and the door locked. All the separate elements of this device have long been in use for different purposes and are old, but the particular combination adapted and intended to interpose protection between the per-

son operating the device and those on the other side of and within the wall or grating was new and patentable and so patented to Mr. May.

40 The plaintiff then, further to maintain the issue on her part, gave evidence tending to show that the patentee, Edwin May, died on the 27th day of February, 1880, at Indianapolis, Indiana; that the plaintiff is his widow; that said widow resides in the State of Illinois and did reside there when suit was commenced.

That the said patented contrivance is useful and economical; that it is in use and has been in use in many jails and prisons since it was patented; that the patentee in his lifetime and the plaintiff since his death have established and collected a royalty of $50 per cell when there had been previous infringement of the patent, and the infringers have settled.

It was admitted that the device employed in the county jail of Juneau county referred to by the witness Moulton was put in said jail in the summer and fall of 1878 and has been in said jail ever since, and that it is applied to eight cells.

The plaintiff then offered in evidence a certified copy of the pleadings and proceedings and charge of court to jury in the case of Edwin May *vs.* The Board of Commissioners of Johnson County, Indiana, which was objected to by defendant as immaterial and irrelevant; which objection was overruled and the defendant excepted. The said copy was then admitted in evidence and read.

The plaintiff then rested her case.

41 Whereupon the defendant, to maintain the issues upon its part, put in evidence a stipulation dated June 4, 1886, touching the facts which one Charles F. Cutler would testify to if present; which stipulation was read and marked Ex. 1, and is hereto annexed.

That the defendant, further to maintain the issues on its part, offered evidence tending to show that the county board of supervisors of the defendant county entered into contract with certain builders to construct the jail in question, which contract is hereto annexed and marked Ex. 3, and put in the device complained of, and that said builders did, pursuant to such contract and subcontract hereinafter mentioned, erect and construct said jail and put in said device; and, further to maintain the said issue on its part, the defendant offered in evidence a subcontract between the said contractors and the Manston Plow and Iron Works, which was duly admitted in evidence and is hereto annexed and marked Exhibit 4; also that the county board, the architect who made the plans and specifications for said jail, and the building committee appointed by said board to supervise the construction, nor any agent or officer of the county, had no knowledge that the device was an infringement of any patent until long after said patent expired, and that since the said jail was completed with the said device for locking

42 and unlocking the cell doors there had been no occasion to use the same for locking prisoners in any of the cells, and that in fact since January 1st, 1879, at which time said jail was first occupied and used by defendant, no prisoner requiring to be locked in his cell had been committed to or confined in said jail.

Defendant also put in evidence stipulation as to use of this device operated within the wall or corridor prior to 1859, marked Ex. 2.

Whereupon, the defendant having rested and the testimony on both sides being closed, the defendant moved the court to direct a verdict for the defendant on the grounds—

1st. That the defendant is merely a territorial division of the State, existing only as a political subdivision thereof, and cannot be sued for the infringement of a patent.

2. That the right of action herein has never been assigned to the plaintiff.

Which motion was on both grounds sustained by the court, and the jury was thereupon instructed to return and did return a verdict for the defendant, on which verdict the judgment appealed from was entered on the — day of February, 1887.

That the plaintiff then and there, when the said ruling was announced, duly excepted to the same, and also to the order directing the jury to return a verdict for the defendant, and to each
43 and every part of said ruling on the said motion.

And because none of the said several proceedings, documents, testimony of witnesses, rulings, motions, objections, and exceptions above set forth appear of record, the judge of said court, before whom the said action was tried, has settled the foregoing as a bill of exceptions in the cause and hereby certifies that the same is a full and complete statement of the evidence given in said cause material to the questions raised by said motions and to all questions passed upon by the court in the disposition of said cause, and has set his hand and seal hereto as a bill of exceptions in said cause.

Madison, Wis., April 25, 1887.

R. BUNN,
District Judge. [SEAL.]

44 Ex. "A."

The May Patent and Extension.

(Copy.)

No. 25662.

THE UNITED STATES OF AMERICA:

To all to whom these letters patents shall come:

Whereas Edwin May, of Indianapolis, Indiana, has alleged that he has invented a new and useful improvement in the construction of prisons, which he states has not been used before his application; has made oath that he is a citizen of the United States; that he does verily believe that he is the original and first inventor or discoverer of the said improvement, and that the same hath not, to the best of his knowledge and belief, been previously known or used; has paid into the Treasury of the United States the sum of thirty dollars and presented a petition to the Commissioner of Patents signifying a desire of obtaining an exclusive property in the said improvement and praying that a patent may be granted for that purpose:

These are, therefore, to grant, according to law, to the said Edwin May, his heirs, administrator, or assigns, for the term of fourteen years from the fourth day of October, one thousand eight hundred and fifty-nine, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given in the words of the said Edwin May in the schedule hereunto annexed, and is made
45 a part of these presents.

In testimony whereof I have caused these letters to be made patent and the seal of the Patent Office has been hereunto affixed.

[SEAL.] Given under my hand, at the city of Washington, this fourth day of October, in the year of our Lord one thousand eight hundred and fifty-nine, and of the Independence of the United States of America the eighty-fourth.

JACOB THOMPSON,
Secretary of the Interior.

Countersigned and sealed with the seal of the Patent Office.

WM. D. BISHOP,
Commissioner of Patents.

The Schedule Referred to in This Patent and Making Part of the Same.

To all whom it may concern:

Be it known that I, Edwin May, of Indianapolis, in the county of Marion and State of Indiana, have invented certain new and useful improvements in the construction and operation of prisons, of which the following is a full and exact description, reference being had to the accompanying drawings and the letters marked thereon.

Figure 1 is a perspective an- figures 2, 3, 4, 5, 6, 7, 8 are sectional views showing the construction and general arrangement of
46 the same. A represents the side and end walls of the prison; B, the floor; C, the outside door; D, inside or angle door; E, moulding or hood over door C; F, the cells; G, the small door of the safe or box J; H, the crank which operates the drum (*p*); I, bolt or lock to the angle door D; *a*, bar connected with the bolts (*s*), which are operated by the levers (*b*) for the purpose of fastening the cell doors (*j*); *c*, fulcrum of the lever (*b*); *d*, levers for operating the sliding doors (*l*); *e*, wire rope or endless chain which operates the levers (*d*); *f*, hinge joints to levers (*d*); *g*, support of pulleys for chain or wire rope; *h*, pulleys over which the chain or wire rope (*e*) operates; *i*, the grated partition; *j*, cell doors; *k*, slide or groove for doors (*l*) to work in; *m*, rollers for sliding doors (*l*); *n*, guard or slide for levers (*d*); *o*, staple to padlock levers (*b*); *q*, pawl or catch to hold the drum (*p*) in place; *r*, rollers for bar (*d*) to work over.

The nature and extent of the improvement will be more readily understood by reference to the object sought, which is, avoiding the necessity of actual contact with the prisoners, while the keeper has perfect knowledge and control of them, and preventing their

escape by knocking down the keeper, which has often occurred where the common arrangement of prisons has been used. It is peculiarly adapted to county prisons and that portion of State prisons appropriated to solitary confinement.

(Here follows diagram marked p. 47.)

48 The following is the manner of operating the same and managing the prisoners: The jailer, opening the outside door C, releases the edge of the small or safe door G, giving access to the crank H, which operates the doors (*l*) in the grated partition (*i*) by means of the endless chain or rope, which passes around the drums (*p*) and is attached to the hinge or joint (*f*) of the lever (*d*).

The angle door D is held by the bolt or lock I, while the keeper is allowed to examine every part of the hall which the peculiar shape of the angle door D allows.

Should there be any prisoners in the first hall they are ordered to retire through the doors (*l*) in the grated partition (*i*). The doors (*l*) are then closed by operating the crank H, as has been shown. The keeper then, unlocking, passes through the angle door D into the first hall, being separated from the prisoners by the grating (*i*), through which he orders the prisoners each to his cell and to close the door after him. By operating the lever (*b*) the bars (*a*) are drawn, while the bolts S, being drawn over the door, secure the same. He then passes in and locks the doors (*i*), whereby an iron grating is always kept between the keeper and the prisoners.

What I claim and desire to secure by letters patent is—

First. The angle door D in combination with the safe lock
49 or bolt I, when constructed and operated substantially as set forth.

Second. The safe J, containing the drum (*p*) and bolt I, and being held by the outer door C, when constructed and operated substantially as set forth.

Third. The endless chain or rope (*e*) in combination with the levers (*d*), when constructed and operated substantially as and for the purposes set forth.

Fourth. The combination and arrangement of the levers (*b*), bar (*a*), and bolts or lugs S, when operated from without the grating (*i*), substantially as and for the purposes set forth.

EDWIN MAY.

Witnesses:
WM. FINDLAY.
WM. THOMAS, JR.

EX. "B."

Certificate of Extension.

Whereas upon the petition of Edwin May, of Indianapolis, Indiana, for the extension of the patent granted him October 4, 1859, for an "improvement in the construction of prisons," the undersigned, in accordance with the act of Congress approved the 8th day

No. 94
May v. Juneau Co. } p. 47

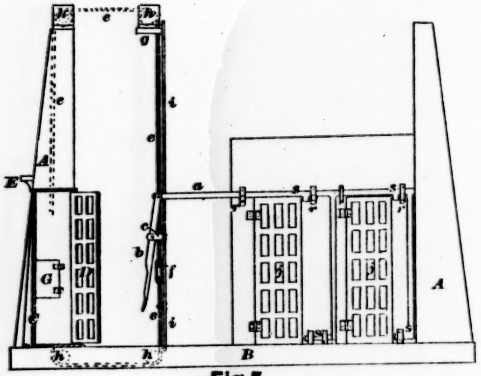
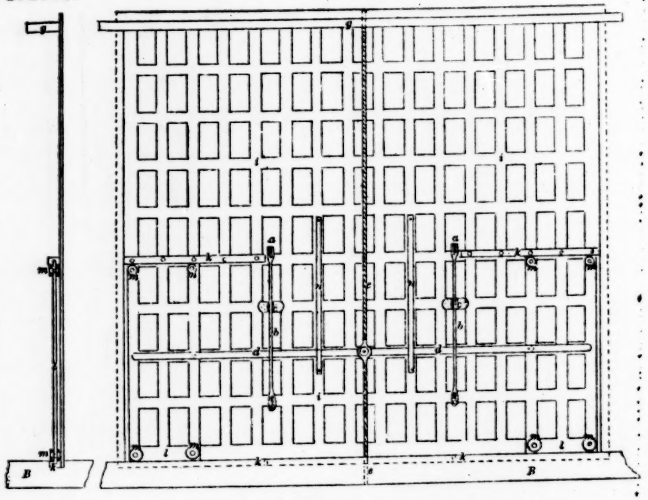


Fig.5.

Fig.6.

No. 2.

No. 3.



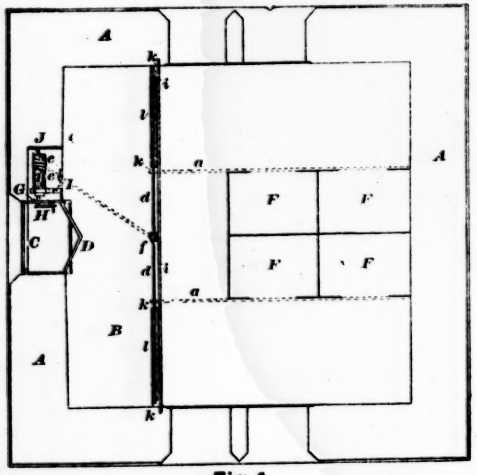
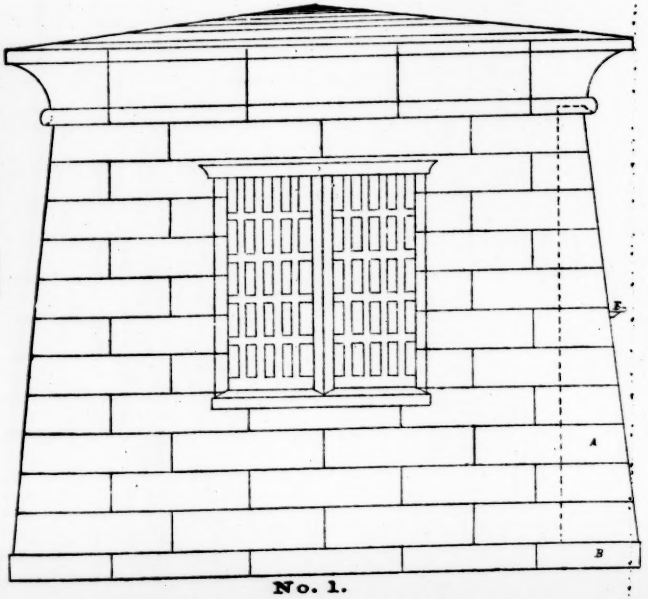


Fig.4.

Fig.7.

Fig.8.



No. 1.

of July, 1870, entitled "An act to revise, consolidate, and amend the statutes relating to patents and copyrights," did, on this 4th day of October, 1873, decide that said patent ought to be extended:

50 Now, therefore, I, Mortimer D. Leggett, Commissioner of Patents, by virtue of the power vested in me by said act of Congress, do renew and extend the said patent and certify that the same is hereby extended for the term of seven years from and after the expiration of the first term, viz., from the fourth day of October, 1873; which certificate being duly entered of record in the Patent Office, said patent has now the same effect in law as though the same had been originally granted for the term of twenty-one years.

In testimony whereof I have caused the seal of the Patent Office to be hereunto affixed this fourth day of October, 1873, and of the Independence of the United States the ninety-eighth.

[SEAL.]

M. D. LEGGETT,
Commissioner.

Ex. "C." 1.

Copy of exemplification of record from the Marion county civil circuit court, at Indianapolis, Indiana, upon which the conveyance from Edwin May's estate to Sarah May was made.

STATE OF INDIANA, } ss:
Marion County, }

Be it remembered that heretofore, to wit, on the 6th day of March, 1880, Edwin Forest May, of the county of Marion, in the State of Indiana, produced and filed in the office of the clerk of the

51 circuit court of said county and State an affidavit showing the time of the death and the value of the personal estate of Edwin May, late of said county and State, deceased, as follows, to wit:

"STATE OF INDIANA, } ss:
Marion County, }

Frank L. Bixby, being duly sworn before the clerk of the circuit court of the county aforesaid, upon oath says that Edwin May departed this life in said county testate, as he believes, on the 27th day of February, 1880; that said decedent left a personal estate to be administered upon of the probable value, as he is informed and believes, of one thousand dollars; and further says not.

FRANK L. BIXBY.

Sworn to and subscribed before me this 6th day of March, 1880.
D. N. RANSDELL, *Clerk.*"

And thereupon said Edwin Forest May executed and filed in said clerk's office a bond as executor of the last will and testament of said Edwin May, deceased, in the penalty of $2,000, with Ingram

Fletcher and Thomas H. Spann, freeholders of said county, sureties therein, approved by such clerk; and, having taken, subscribed, and filed the oath required by law, letters testamentary upon said estate were duly granted and issued to said Edwin Forest May, which, with said bond and oath, were duly recorded in the
52 book provided and kept for that purpose.

"D."

And be it further remembered that afterwards, to wit, at a regular term of the civil circuit court of the county of Marion and State of Indiana, held at the court-house, in the city of Indianapolis, Indiana, on the fifth day of June, 1880, the same being the 30th judicial day of the May term, 1880, of said court, before the Honorable Joshua G. Adams, sole judge of said court, the following proceedings were had in the matter of Edwin May's estate:

Comes now Edwin F. May, executor of the last will and testament of Edwin May, deceased, and files his report and resignation, showing that he is chargeable by the inventory filed herein in the sum of $3,428.86 and entitled to credits by property taken by the widow, $302.20; by difference in receipts from sale of personal property and inventory of $1,365.14, leaving in his hands $1,761.52; that he has paid out on account of his said trust the sum of $1,955.50, showing an overpayment by him of $193.98, which he asks may be made a charge against said estate, which report and resignation are as follows: (Omitted.)

And the court, having examined said report and being duly advised in the premises, does approve and confirm the same, and
53 said overpayment by said executor is made a charge against said estate, to be paid him out of any moneys that may come into the hands of his successor herein that may be lawfully applied to the payment of said claim. The resignation of said executor is accepted, and he is hence discharged from the duties of his said trust.

Ex. "E." 2.

And be it further remembered that afterwards, to wit, on the 7th day of June, A. D. 1880, George F. McGinnis, of the county of Marion and State of Indiana, executed and filed in the office of the clerk of the circuit court of said county and State his bond as administrator *de bonis non*, with the will annexed, of the estate of said Edwin May, deceased, in the penalty of $15,000.00, with Theo. P. Haughey surety thereon, approved by such clerk; and, having taken, subscribed, and filed the oath required by law, letters of administration *de bonis non* with the will annexed, were duly granted and issued to him by such clerk, which, with said bond and oath, were duly recorded in the book kept for that purpose; which said bond, oath, and letters are in the words and figures following, to wit:

Know all men that we, George F. McGinnis and Theo. P. Haughey, all inhabitants of the State of Indiana, are bound unto the

State of Indiana in the penal sum of fifteen thousand dollars;
54 for the payment of which we, jointly and severally, bind ourselves, our heirs, executors, and administrators.

Sealed and dated the 7th day of June, 1880.

The condition of the above obligation is that if the above-bound George F. McGinnis shall faithfully discharge the duties of his trust as administrator *de bonis non* of the estate of Edwin May, deceased, according to law, then the above obligation is to be void; else to remain in full force.

GEO. F. McGINNIS. [SEAL.]
THEO. P. HAUGHEY. [SEAL.]

Taken and approved by clerk this 7th day of June, 1880.
Attest: D. M. RANSDELL,
Clerk Marion Circuit Court.

STATE OF INDIANA, } ss:
Marion Co., }

I, George F. McGinnis, swear that I will faithfully discharge the duties of my trust as administrator *de bonis non* of the estate of Edwin May, deceased, according to law, so help me God.

GEO. F. McGINNIS.

Subscribed and sworn to before me this 7 day of June, 1880.
D. M. RANSDELL,
Clk of Marion Circuit Court.

STATE OF INDIANA, } ss:
Marion County, }

Theo. P. Haughey, being duly sworn before the clerk of the circuit court of said county and State, upon oath depose- and
55 say- that he is worth over and above all indebtedness the full amount of the penalty of the within bond in real estate situated in said State.

THEO. P. HAUGHEY.

Subscribed and sworn to before me, clerk as aforesaid, this 7th day of June, A. D. 1880.

D. M. RANSDELL, *Clerk.*

Letters of Administration.

STATE OF INDIANA, } set:
Marion County, }

To whom these presents shall come, Greeting:

I, D. M. Ransdell, clerk of the Marion circuit court within and for the county of Marion and State of Indiana, do hereby certify that administration of the personal property of Edwin May, late of said county of Marion, deceased, is granted to Geo. F. McGinnis, and he, having qualified and given bond as such administrator *de*

bonis non, etc., is duly authorized to take upon himself the administration of such estate according to law.

Witness my hand and the seal of said court, at the city of Indianapolis, this seventh day of June, 1880.

[SEAL.] D. M. RANSDELL,
Clk of Marion Circuit Court, Ind.

Ex. "F."

And be it further remembered that afterwards to wit, at a regular term of the civil circuit court of the county of Marion and
56 State of Indiana aforesaid, held at the court-house, in the city of Indianapolis, State of Indiana, on the 31st day of December, 1881, being the 24th judicial day of the December term, 1880, of said court, before the Hon. Joshua G. Adams, sole judge of said court, the following further proceedings were had:

In the Matter of EDWIN MAY'S Estate.

Now comes Geo. F. McGinnis, administrator of said estate of said decedent, and files his petition for the sale of certain patent rights at private sale in the words and figures following, to wit:

STATE OF INDIANA, } *sct:*
Marion County, }

Civil Circuit Court.

In the Matter of the Estate of EDWIN MAY, Deceased.

George F. McGinnes, administrator of the estate of said decedent, showeth to the court that all the real and personal estate of said decedent which has come to the hands or knowledge of this administrator has been sold and the proceeds distributed under the direction and order of this honorable court, except the rights of said decedent in certain letters patent from the United States of America, which have not been disposed of; that there now offers a favorable opportunity for selling such rights; that the same are of little value, and that your petitioner believes that it is for the best inter-
57 est of said estate to sell said rights at private sale without appraisement or advertisement, saving the cost thereof.

GEO. F. McGINNIS.

Subscribed and sworn to this 31st day of December, 1881, before me—

[SEAL.] LEW. WALLACE,
Notary Public.

"G."

And the court, having examined into such petition and heard the evidence, and being fully advised in the premises, finds that it is for the best interest of said estate to sell such rights at private sale without the delay and expense of appraisement and advertisements,

and said administrator is now authorized and empowered by the court to sell said rights at private sale without advertisement or appraisement, and is ordered to report his doings at the next term of this court.

And time is given.

Ex. "I." 4.

And be it further remembered that afterwards, to wit, at a further term of said Marion civil circuit court, held at the court-house aforesaid on the 7th day of March, A. D. 1882, being the 20th judicial day of the February term, 1882, of said court, before the hon. judge last aforesaid, the following further proceedings were had in the matter of Edwin May's estate:

58 Comes now Geo. F. McGinnes, administrator *de bonis non* of said estate, and files his report of the sale of certain letters patent heretofore ordered by the court, said report being in the words and figures following:

STATE OF INDIANA, } *sct:*
Marion County, }

Marion Civil Circuit Court.

In the Matter of the Estate of EDWIN MAY, Deceased, and Petition to Sell Certain Letters Patent.

Geo. F. McGinnes, administrator *de bonis non* of the estate of said decedent, Edwin May, presents the following report of his doings in respect to the order heretofore entered by this court, authorizing said administrator to sell at private sale the rights of said estate in certain letters patent: This administrator made diligent efforts to secure bids for such rights, and on the 19th day of January, A. D. 1882, Mrs. Sarah May did bid therefor the sum of fifteen dollars, and, that being the best offer this administrator could procure, such rights were by this administrator sold to said Sarah May, and said Sarah May having paid said bid this administrator executed to her a deed of assignment of such rights, which he now brings into court for approval.

Wherefore said administrator prays that said sale and said deed be approved and confirmed.

GEO. F. McGINNIS,
Administrator.

59 And the court, having examined such report, and being fully advised in the premises, ratifies and confirms said sale.

And said administrator also presents for the approval of the court his deed of assignment pursuant to such sale, and the court, having examined such deed, ratifies, confirms, and approves the same.

All of which is finally ordered, adjudged, and decreed by the court.

STATE OF INDIANA, } ss:
Marion County, }

I, Moses G. McLain, clerk of the circuit court within and for said county and State, being a court of record and having probate jurisdiction, do hereby certify that the above and foregoing contains a full, true, and correct transcript of so much of the proceedings had in the settlement of the estate of Edwin May, late of said county and State, deceased, as shows the application and appointment of Edwin Forest May as executor of the last will and testament of said decedent, with a copy of the affidavit showing the date of death and probable value of the estate of said decedent to be administered, and a copy of the proceedings of the court approving the final report and accepting the resignation of said executor; also the appointment of Geo. F. McGinnis as administrator *de bonis non* with
60 the will annexed of said estate, together with a copy of the bond executed and filed by him and of the letters of administration granted and issued to him; also a true copy of the proceedings had and orders made by said court relating to the sale of certain letters patent belonging to said estate, all of which fully appears from the records of said court in my custody and on file in my office.

[SEAL.] In testimony whereof I hereunto subscribe my name and affix the seal of said court this 30th day of December, 1884.

MOSES G. McLAIN,
Clerk Marion County Circuit.

STATE OF INDIANA, } ss:
Marion County, }

I, Alexander C. Ayres, sole judge of the circuit court of Marion county and judge of the nineteenth judicial circuit of the State of Indiana, do hereby certify that Marion county, in the State of Indiana, is comprised within and is a part of the said nineteenth judicial circuit of said State, and that the foregoing attestation and certificate of Moses G. McLain, clerk, are in due form of law, and that the said Moses G. McLain is and at the time of the making of said certificate and attestation was the clerk of the said circuit court of Marion county, in said State, and is and at said time was the proper officer to make such attestation and certifi-
61 cate, and that his signature thereto is genuine, and that as such clerk he is the sole custodian of the papers, documents, records, and seals pertaining to said court.

Witness my hand and the seal of the said court, affixed at
[SEAL.] the city of Indianapolis, Indiana, this 30th day of December, 1884.

ALEXANDER C. AYERS,
Judge of the Circuit Court of Marion County, Indiana.

STATE OF INDIANA, } ss:
Marion County, }

I, Moses G. McLain, clerk of the circuit court of Marion county, in the State of Indiana, do hereby certify that Alexander C. Ayers, whose signature appears in the foregoing certificate, is and was at the time of signing said certificate the sole judge of said court, duly commissioned and qualified in accordance with the laws of the State of Indiana.

In testimony whereof I have hereunto set my hand and affixed the seal of said court, at the city of Indianapolis, Indiana, this 30th day of December, A. D. 1884.

MOSES G. McLAIN,
Clerk of the Circuit Court of Marion Co., Indiana.

Ex. H.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE.

To all persons to whom these presents shall come, Greeting:

This is to certify that the annexed is a true copy from the
62 records of this office of an instrument of writing executed by George F. McGinnes, administrator of the estate of Edwin May, deceased, March 6, 1882, and recorded in Liber Z 34, page 54; said record had been carefully compared with the original and is a correct transcript thereof.

In testimony whereof I, M. V. Montgomery, Commissioner of Patents, have caused the seal of the Patent Office of the United States to be affixed this 13th day of March, in the year of our
[SEAL.] Lord one thousand eight hundred and eighty-six, and of the Independence of the United States the one hundred and tenth.

M. V. MONTGOMERY,
Commissioner.

Know all men by these presents that whereas Edwin May, late of Marion county, in the State of Indiana, deceased, did during his life obtain of the United States of America certain letters patent for inventions and discoveries as follows:

First. Certain letters patent for an improvement in the construction of prisons, dated October 4th, 1859, and numbered 25662, and in the extension of said letters patent granted to said Edwin May and dated October 4th, 1873.

Second. Certain letters patent for an improvement in the construction of prisons, dated December 27th, 1870, and numbered 110,483.

Third. Certain letters patent for an improvement in the
63 construction of prison walls, dated June 28th, 1870, and numbered 104,865.

Fourth. Certain letters patent for an improved fire-proof building, dated May 4th, 1869, and numbered 89782.

Fifth. Certain letters patent for an improvement in fire-proof buildings, dated January 26th, 1869, and numbered 86312.

Sixth. Certain letters patent for an improvement in sheet-metal lath machine, dated April 13th, 1869, and numbered 88972.

And whereas said Edwin May having departed this life the sole owner of said letters patent and I, George F. McGinnis, of Marion county, in the State of Indiana, having been by the Marion civil circuit court of said Marion county, Indiana, duly appointed administrator *de bonis non* of said estate of said decedent, did, on the 31st day of December, 1881, procure from said Marion civil circuit court an order of said court, duly entered — Order Book No. 56 of said court on page 485, wherein said court did authorize, empower, and direct me, as such administrator, to sell at private sale all the right, title, interest, claim, and demand of said estate in, by, under, and through said letters patent and each of them;

And whereas in pursuance to such order I did, on the 19th day of January, 1882, at private sale, sell all and singular the letters patent aforesaid and all the right, title, interest, claim, and
64 demand of said estate in, to, by, under, and through the same to Sarah May, of the said Marion county, in the State of Indiana, for the sum of fifteen (15.00) dollars, that being the highest and best bid and offer for such rights:

Now, therefore, to all whom it may concern be it known that for and in consideration of the said sum of fifteen ($15.00) dollars, to me in hand paid, and in pursuance to the order and authority aforesaid, I, the said Geo. F. McGinnis, as administrator of the estate of said Edwin May, deceased, have sold, assigned, transferred, and set over, and do hereby sell, assign, transfer, and set over, unto the said Sarah May all the right, title, interest, claims, and demands whatsoever which the said estate of said Edwin May, deceased, has into, by, under, and through the said improvements and the letters patent and extensions thereof therefor aforesaid; the same to be held and enjoyed by the said Sarah May for her own use and behoof and for the use and behoof of her legal representatives to the full end of the term for which said letters patent and extensions thereof are or may be granted as fully and entirely as the same would have been held and enjoyed by said estate had this assignment and sale not been made, and as, by and under the order and authority aforesaid, I, as such administrator, can or ought to grant, sell, and assign the same.

65 In testimony whereof I, George F. McGinnis, administrator of the estate of Edwin May, deceased, have hereunto set my hand and affixed my seal this 6th day of March, A. D. 1882.

GEO. F. McGINNIS, [SEAL.]
Administrator of the Estate of Edwin May, Deceased.

In the presence of—
CHARLES PLESCHNEY.
JOHN SHARNE.

March 7th, 1882, examined and approved by the court.
J. G. ADAMS, *Judge.*

UNITED STATES OF AMERICA, }
District of Indiana. }

In the Circuit Court of the United States for the District of Indiana.
November Term for 1870.

Edwin May, a citizen of the State of Indiana, complains of the board of county commissioners of Johnson county, Indiana, a citizen of said State, in a plea of trespass on the case, that whereas the said Edwin May, before and at the time of the making of the letters patent and of committing the grievance by the said defendants as hereinafter mentioned, was the true and first inventor of a certain improvement in the construction of prisons, to wit, at said district of Indiana, and thereupon the United States of America hereto-
66 fore, to wit, on the fourth day of October, in the year of our Lord one thousand eight hundred and fifty-nine, in said United States, by their letters patent, bearing date at the city of Washington the day and year aforesaid, under the seal of the Patent Office, and which said letters patent the said plaintiff now brings here into open court, reciting that whereas Edwin May, of Indianapolis, Indiana, has alleged that he has invented a new and useful improvement in the construction of prisons, which he states has not been known or used before his application, and has made oath that he is a citizen of the United States; that he does verily believe that he is the original and first inventor or discoverer of the said improvement, and that the same hath not, to the best of his knowledge and belief, been previously known or used; has paid into the Treasury of the United States the sum of thirty dollars and presented a petition to the Commissioner of Patents signifying a desire of obtaining an exclusive property in the said improvement and praying that a patent may be granted for the purpose; and therefore the letters patent were granted according to law to the said Edwin May, his heirs, administrators, or assigns, for the term of fourteen years from the fourth day of October, one thousand
67 eight hundred and fifty-nine, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given in the schedule annexed and made a part of said letters patent, — reference thereunto being had will more fully and at large appear; and the said plaintiff further says that he, the plaintiff, has always, from the time of making the said letters patent as aforesaid, made, used, and exercised the said invention to his great advantage and profit, to wit, at the district of Indiana aforesaid; yet the said defendant, well knowing the premises, but contriving and wrongfully intending to injure the said plaintiff and deprive him of the profits, benefits, and advantages which he might and otherwise would have derived and acquired from the making, using, exercising, and vending of the said invention after the plaintiff had invented the said improvement, with full notice thereof and of the plaintiff's rights in the premises, and within the said term of years in said letters patent mentioned, to wit, on the day and year last aforesaid, and on different other days before the commencement of this suit,

and within the United States of America, to wit, at the district of Indiana, unlawfully and unjustly and without leave or license and against the will of the said plaintiff made or caused to be made an improvement in the construction of
68 prisons in imitation of the said invention of the said plaintiff aforesaid, in breach of the said letters patent and against the privileges so granted to the plaintiff aforesaid, whereby the said plaintiff has been and is greatly injured and deprived of a great part of the profits and advantages which he might or otherwise would have derived and acquired from the said invention, to wit, at the district of Indiana aforesaid.

2nd. And the said plaintiff further says that he, the said plaintiff, so being the inventor as aforesaid, and the said letters patent having been so made as aforesaid, and the said invention having been *a* made, used, and exercised as aforesaid by the said plaintiff as aforesaid, the said defendants, well knowing the premises, but further contriving and intending as aforesaid, after the making of the said letters mentioned, to wit, on the day and year last aforesaid and on several other days and times between that day and the day of the commencement of this suit, to wit, at the district of Indiana aforesaid, unlawfully and unjustly and without leave or license and against the will of the said plaintiff, used and put in practice an improvement in the construction of prisons in imitation of the invention of the said plaintiff, in breach of the said letters patent and against the privileges so granted to the said plaintiff and his assigns as aforesaid, whereby the said plaintiff has been and is greatly injured
69 and has lost and been deprived of divers great gains and profits which he might and otherwise would have derived and acquired from the said invention, to wit, at the district aforesaid.

3rd. And the said plaintiff further says that he, the said plaintiff, so being such inventor as aforesaid, and the said letters patent having been so made as aforesaid, and the said invention having been so made, used, and exercised by the said plaintiff as aforesaid, the said defendants, well knowing the premises, but further contriving and intending as aforesaid, after the plaintiff had invented the said improvement, with full notice thereof and of the plaintiff's rights in the premises and within the said term of years in the said letters patent mentioned, to wit, on the day and year last aforesaid and on different other days and times between that day and the day of the commencement of this suit, to wit, at the district of Indiana, unlawfully and unjustly and without leave or license and against the will of the said plaintiff, did imitate the said invention and did put in practice an improvement in the construction of prisons, in breach of the said letters patent and against the privileges so granted to the plaintiff and his assigns as aforesaid, whereby the said plaintiff has been greatly injured and has lost and been deprived of divers great gains and profits which he might and otherwise would have derived and acquired from the said invention, to wit, at the district aforesaid. Wherefore the said plaintiff says that he is injured and sus-

70 tained damages to the amount of one thousand dollars. Wherefore he brings this suit.

NICHOL AND JORDAN,
For Plaintiff.

In the United States Circuit Court.

EDWIN MAY
vs.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

And the said defendant-, by M. M. Ray, their attorneys, comes and defends the wrong and injury, when, &c., and says that they are not guilty of the said supposed grievance above laid to their charge, or any or either of them or any part thereof, in manner and form as the plaintiff hath above complained of against *him;* and of this the defendant- put themselves upon the count-y, and c.

M. M. RAY,
Attorney for Defendants.

Circuit Court United States, District of Indiana.

EDWIN MAY
vs.
THE BOARD OF COMMISSIONERS OF JOHNSON CO.

Nichol and Jordan, attorneys for plaintiff:

Take notice that the above-named defendant- on the trial of this cause will give in evidence under the general issue and insist that in the year 1870 the defendants, as The Board of Commis-
71 sioners of Johnson County, Indiana, caused a jail to be constructed at Franklin for the use of Johnson county, and in the prosecution of said work they let the iron-work to Haugh and Co., of the city of Indianapolis, and that prior to that time, to wit, on the 16th day of June, 1868, one Isaac Hodson, a citizen of the United States, had issued to him — from and by the Patent Office of the United States, in due form of law, for a new and useful improvement in the construction of prisons, and which improvement was novel and useful and of which said Hodson was the inventor and patentee and which was not an invasion or infringement of the plaintiff's patent, because the two patents are quite different from each other, as appears by reference to the original letters patent so issued to the said Hodson, which are referred to and made part of this notice. Defendants will also offer evidence and insist at the trial, 1st, that the plaintiff's patent is void as attempting to patent a principle instead of an application of a principle; 2nd, that the same as an invention or improvement is neither novel nor useful. The defendant- will also show that the board of commissioners of Johnson county did not manufacture or use the plaintiff's supposes patent for any purpose of their own, but only permitted the improvement to be used and applied by said Haugh and Co., who contracted with them to do and complete the iron-work of said

jail, the defendant- not knowing that the plaintiff claimed any
72 interest in the same, but supposed that said Haugh & Co. had good right and lawful authority to use the same. The plaintiff will also take notice that the defendant- will offer in evidence and insist on the trial of this cause that the supposed invention and improvement in prisons used by said Haugh & Co. in the said jail was and is not an infringement of any patent claimed by the plaintiff, as set forth in his declaration, but that the same is constructed and used by said Hodson, Haugh & Co., and the defendant- under, by virtue of, and in conformity with the said patent of the said Hodson with the leave, license, and special authority of the said Hodson, and that said Hodson's said patent is novel and useful, and that he is the original inventor of such improvement in prisons as his patent purports to be, and that the manufacture of the same, and the use of the same by the said Hudson and Haugh & Co. and the suffering the same to be used in the jail of Johnson county by defendants was and is justified by the said patent of the said Hodson, and that said defendant- *is* suffering the said supposed improvement to be used, having — notice or knowledge that the plaintiff claimed or owned any interest therein as patentee or otherwise. For a more particular description of the patent of said Hodson the defendant-
73 refers to the patent claimed by and in the specifications, drawing, and exemplifications and letters patent now presented herewith.

M. M. RAY,
Attorney for Defendant-.

In the Circuit Court of the United States, District of Indiana. May Term, 1872.

EDWIN MAY
vs.
THE BOARD OF COMMISSIONERS OF JOHNSON CO.

Now, the said plaintiff, as to the second and third plea by the said defendant above pleaded and each of them, saith that the same and each of them and the matter therein and in each of said pleas contained as the same in the several pleas are above pleaded and set forth are not sufficient nor is either of them sufficient in law to preclude the said plaintiff from having or maintaining his aforesaid action; wherefore the said plaintiff prays judgment of the said several pleas, &c.

And for the special cause of demurrer as to the said second and third pleas the said plaintiff says that the said defendant has not traversed or denied or attempted to put in issue any matter or thing in the said declaration except what is traversed in the first plea by the said defendant above pleaded, nor has *he* introduced or attempted to introduce any new matter by way of demand, but the said pleas and each of them are argumentative and evasive; and for further

special causes of demurrer as to the said second — third pleas
74 the said plaintiff says that said pleas and each of them amount to the general issue, which is also pleaded in form by the said defendant in the first plea as above pleaded. This the plaintiff is ready to verify, &c.

M. NICHOL,
McDONALD, BUTLER AND McDONALD,
Att'ys for Pl'ffs.

In the United — Circuit Court, Indiana.

EDWIN MAY
vs.
THE BOARD OF COMMISSIONERS OF JOHNSON CO.

No. 1. And the said defendant, The Board of Commissioners of Johnson County, Indiana, by Henfricks, Hord & Hendricks and M. M. Ray, their attorneys, comes and defends the wrong and injury when, &c.; that they did not undertake and promise nor commit the grievance in manner and form as the plaintiff has above thereof complained against them, and of this they put themselves upon the country, &c.

No. 2. And for further and second pleas in this behalf the defendant says that the plaintiff ought not to recover against the defendant, because they say that the plaintiff's supposed patent is neither novel nor useful, and that the same was not when patented nor is it now an art, machine manufacture, or composition of matter within the meaning of any act of Congress, and that supposed invention—lock and machine—was known and in general use before the
75 plaintiff's patent was issued, because the defendant says that before the plaintiff procured his patent, to wit, on the 20th day of January, 1856, one Edwin Kershaw had discovered and published the identical invention or improvement in the plaintiff's complaint mentioned, and did on the day and year aforesaid apply for and obtain letters patent thereon in the name of himself and Henry M. Hooper & Co., all of whom then were and still are of the city of Boston, State of Massachusetts, under the name and descriptions—improved cell lock—duly issued by the Government of the United States, and thereupon published by the authority of the United States in the regular Patent Office Reports for the year 1856, with a full description thereof, and fully illustrated by drawing published by authority of the United States in vol. No. 3 of the Patent Office Reports published in and for the year 1856, on page 39 thereof, which drawing is numbered 14178, and this description of said patented improvement is found on page 380 of the volume No. 1 of the said Patent Office Reports of year 1856; wherefore the defendant says the supposed invention of the plaintiff was fully known and published by said Edwin Kershaw and Henry M. Hooper in the year 1856 in manner and form aforesaid, and therefore the defendant says the said supposed patent of the plaintiff is void for want of novelty; all of which defendant is ready to verify.

HENDRICKS, HORD & HENDRICKS AND
M. M. RAY, *Attorneys for Defendant.*

76 No. 3. The defendant for further and third pleas says the plaintiff should not recover because they say that as the board of commissioners of the said county of Johnson, at the town of Franklin, in the county of Johnson, they caused to be erected a county jail for said county, and that in the construction thereof they employed William Haugh & Co., of the city of Indianapolis, who were and are manufacture-s of iron cells, grates, doors, locks, fastenings, and other devices for the security of prisoners in jails; that Haugh & Co. manufactured and put into said jail the necessary cells, grates, doors, and other fastenings, among which was the supposed lock and fastening claimed by said plaintiff to be an imitation and an infringement on his supposed patent of the right to make, vend, and use, which this defendant had no knowledge, nor did they assume to have any knowledge, but permitted the same Haugh & Co. to put the same in use in the said jail as part of the whole job under said contract for the iron-work of said jail; that said lock — claimed by the plaintiff to be an improvement in prisons, which the said Haugh & Co. put in use in the said jail by permission of the defendants, but on the contrary thereof—

The same was an improvement which was patented to and secured to the said Haugh & Co. by one Isaac Hodson, Esq., of the city of Indianapolis, Ind., and under a license and permission of the
77 said Hodson the said Haugh & Co. had the right to manufacture, vend, and use and who did manufacture, vend, and use the same in the prosecution of their said business, and who did manufacture and place in the jail of the said county the said improvement in prisons as aforesaid, under his said contract as aforesaid, and at no other time or place or in any other form or manner or in any other sense did the defendant manufacture, use, or cause to be manufactured or used the plaintiff's said supposed invention.

The defendant further says that on the 10th day of June, 1868, the said Hodson, having complied with all the requirements of the laws of Congress on the subject — procuring patents, did have granted him a patent, which was fully issued by that date — letters patent and duly signed by the Secretary of the Interior of the United States of America, for an improvement in the constructions of prisons, which is the same improvement, invention, and lock which the said Haugh & Co. put into the Johnson county jail, as aforesaid, and not the improvement, invention, or lock covered by the plaintiff's supposed patent, but covered by the said patent of the said Isaac Hodson, and the right to manufacture, vend, and use which was then and now secured to the said Haugh & Co. by grant and license, as and under which the defendant claims protection, which letters patent
78 to the said Hodson *and* defendants now bring into court and make profert thereof.

All which facts herein pleaded this defendant is ready to verify as the court may direct.

HENDRICKS, HORD & HENDRICKS AND M. M. RAY, *Att'ys for Defendants.*

Notice of Special Matter.

The plaintiff will take notice that the defendant will introduce upon the trial of the above-entitled cause by way of defence that on the 16th day of June, 1868, the Government of the United States granted and issued letters patent to one Isaac Hodson, Esq., of the city of Indianapolis, Indiana, for an improvement in the construction of prisons; that said Hodson granted a license to manufacture, use, and vend the said patented improvement to one Haugh & Co., iron mauufacturers and manufacturers of jails, cells, grates, doors, locks, &c., for prisons; that defendant, as commissioners of Johnson county, Ind., caused to be constructed a jail for said county in the year 1870 at the expense of said county, and that as such commissioners they contracted with said Haugh & Co. to put in said jail all iron cells, grates, doors, locks, &c., and that in pursuance of said contract the said Haugh & Co. put into the said jail the said
79 improvement in the construction of prisons, which consisted of a patent lock, and which the defendant will insist is not the same lock and improvement covered by the supposed letters patent of the plaintiff, but is covered strictly by the letters patent of the said Isaac Hodson, and that this is the same use complained of by the plaintiff, and that therefore the defendant is not guilty of infringement of plaintiff's supposed patent; all of which will be given on the trial under the general issue, and that the defendant will produce on the trial the said letters patent, and will prove the license to use the same as aforesaid.

HENDRICKS, HORD & HENDRICKS AND
M. M. RAY, *Att'ys for Defendants.*

No. 4. And for further plea the defendant says that plaintiff ought not to maintain said action against them, because they say that the board of commissioners of Johnson county is a political corporation, and was such at the time of committing the grievance in the declaration mentioned, with certain legislative and administrative powers and duties under the laws of the State of Indiana, constituting one of the geographical and administrative subdivisions of the State of
80 Indiana, and so not liable, because as such corporation the defendant caused a new jail to be built for Johnson county, Indiana, by contract with Haugh & Co., and in the construction of the iron-work in the interior thereof the said Haugh & Co. put in use the said patent of the plaintiff.

HENDRICKS, HORD & HENDRICKS AND
M. M. RAY, *Att'ys for Defendant.*

EDWIN MAY
vs.
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The defendant-, by Hendricks & Ray, their attorneys, move the court to set aside the verdict of the jury herein and to grant defendant a new trial herein for the following causes and reasons, to wit:

1st. The court erred in overruling the plaintiff's demurrer to the defendants' several pleas as it related to the plaintiff's declaration, as to which declaration the said demurrer should have been sustained, and because the court sustained the said demurrer to the fourth plea pleaded by the defendant.

2nd. The court erred in giving the jury the instructions numbered 1, 2, 3, 4, 5, 6, & 7 of the written charge of the court.

HENDRICKS & RAY.

EDWIN MAY
vs.
THE BOARD OF COMMISSIONERS OF JOHNSON CO.

81 The defendant-, by Hendricks & Ray, their attorneys, move the court, this court having overruled their motion for a new trial herein, to arrest the judgment on the verdict herein, and for cause say that the declaration in this cause does not state a cause of action against the defendant, the said defendant being a political corporation only and there being no law shown whereby the board of county commissioners of Johnson county are made liable for a tort for the infringement of a patent right. Therefore the defendant moves in arrest of the judgment of the court on said verdict.

HENDRICKS & RAY,
Att'ys for the Def't.

In the United States Circuit Court for the District of Indiana. May Term, 1872.

EDWIN MAY
vs.
THE BOARD OF COMMISSIONERS (?) JOHNSON COUNTY.

Be it remembered that in making the issue in this cause the defendant filed the general issue and notice of special matter under the same, and also three special pleas, to each of which the plaintiff demurred on the ground that neither of them constituted any
82 bar to the plaintiff- suit; and thereupon the defendant insisted upon and pointed out that the plaintiff's declaration -as insufficient and did not show a sufficient cause of action against the defendant as a corporation, and therefore insisted that this court should sustain said demurrer to the plaintiff's declaration; but the court overruled said demurrer as to the plaintiff's declaration and sustained said demurrer as to the fourth plea of the defendant; to which ruling of the court the defendant excepted at the time. And be it further remembered that on the trial of the cause the plaintiff introduced his letters patent and other evidences tending to show that the defendant by the use of a certain iron jail-fastening in the Johnson county jail had infringed the plaintiff's patent. Defendants on their part introduced letters patent of one Isaac Hodson, under whose patent the defendant had constructed and used said jail-fastenings, and also other evidence tending to prove that the

said Hodson patent was not an infringement on the plaintiff'- patent. The court instructed the jury as follows, to wit:

(Here insert instructions.)

To the giving of each of which instructions numbered 1, 2, 3, 4, 5, 6, & 7 the defendant at the proper time excepted.

And be it further remembered that after deliberation the
83 jury returned into open court a verdict for the plaintiff, assessing his damages at four hundred dollars, and thereupon the defendant moved the court for a new trial herein and filed the following causes therefore, to wit:

(Here insert causes for new trial.)

And thereupon the court overruled the defendant's motion for a new trial; to which ruling of the court the defendant at the time excepted; and thereupon the defendant moved the court in arrest of judgment upon the verdict of the jury and filed the following causes therefore, to wit:

(Here insert causes.)

Which motion in arrest of judgment was overruled by the court, and the defendant then and there excepted to the ruling of the court, and thereupon rendered judgment of the said verdict; to which ruling of the court in rendering the judgment on the said verdict the defendant excepts and prays the court to sign and seal this his bill of exceptions.

Which is accordingly done.

DAVID DAVIS.

In the U. S. Circuit Court. May Term, 1872.

EDWIN MAY
vs.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

Come- now the plaintiff and move- the court to strike out
84 the special matter set out in the notice attached to the plea of the said defendant pleaded, because he says that said alleged special matter does not amount to any defense to his aforesaid action.

NICHOL, McDONALD, BUTLER & McDONALD,
Att'ys for Plaintiff.

In the U. S. Circuit Court. May Term.

EDWIN MAY
vs.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

Comes now the plaintiff, and for reply to the second plea the said defendants pleaded — prelude him, because he says that the defendants, of their own wrong and without any of the causes in said plea mentioned, committed the grievance complained of in his said declaration mentioned; and that he prays may be enjoined of by the count-y, &c.

NICHOL, McDONALD & McDONALD,
Att'ys for Plaintiff.

In the Circuit Court of the United States for the District of Indiana.
May Term, 1872.

Before the Honorable David Davis, Judge.

EDWIN MAY
vs.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

JUNE 1, 1872.

85 Come again the parties, by their respective attorneys; and the jury heretofore empanelled and sworn herein also comes and return- into court the verdict following:

We, the jury, find for the plaintiff and assess his damages at the sum of four hundred dollars.

In the Circuit Court of the United States for the District of Indiana.
May Term, 1872.

Before the Honorable David Davis, Judge.

EDWIN MAY
vs.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

JUNE 5, 1872.

Comes now the plaintiff, by counsel, and moves to the court for judgment upon the verdict heretofore rendered herein. It is therefore considered by the court that the plaintiff do recover of the defendant the said sum of four hundred dollars, together with his costs and charges in their behalf laid out and expended, taxed at —.

I.

The charge of Judge David Davis, of the United States Supreme Court, to the jury on the May patent, in the case of Edwin May *vs.* The Commissioners of Johnson County, Indiana, in the
86 circuit court of the United States for the district of Indiana, in 1872.

The laws of Congress not only secure a party for a limited term of years a property right in a new and useful invention, if the subject-matter of a patent possesses the requisites of novelty and utility, but it is protected against the encroachments of any society, and no one has the right to use it without paying for it. By a natural law the creations of a man's genius are as much his own property as the house or land he may purchase with money he has earned; and the patent law, in order to encourage the inventive faculty, recognizes patentable an improvement in any art which is useful to the public and not before known, although the result is produced by a mechanism which combines old mechanical powers without the use of any new element. The true question in such a case is whether the combination of materials by the patentee is new. If they have never been combined together in the manner stated in the patent, but the combination is new, then the invention of the combination is patentable. So far as the evidence goes it does not appear that any such combination was known or in use before May's invention. The jury have, therefore, only to consider whether
87 Hodson's structure is an infringement on May's. Hodson's structure seeks to accomplish the same result as May's. Both construct prisons so as to avoid the necessity of actual contact with the prisoners, while the keeper can observe their movements and control them. The utility of such an invention commends itself to the common mind and does not need to be enlarged upon.

To construct a jail so that prisoners can be safely kept and their movements controlled and the jailer secured from violence is a beneficial object. Does Hodson's structure infringe on May's? In their scope and object they are alike and evidently intended to secure the same result. Do they differ essentially in their organization or mode of operation? The one is evidently equivalent to the other as producing the same result, but in this sense it is not material to consider the subject. The main question is whether Hodsons has used substantially the same means or, mechanically speaking, equivalent means to accomplish the same result. If he has he is an infringer; otherwise not; and whether he has or not is a question for the jury to determine. A mechanical equivalent, as generally understood, is when one may be adopted instead of the other by a skilled mechanic accustomed to machinery and with a competent knowledge of mechanical
88 powers. If such a man, seeing a new machine and having a full description of the thing invented, can by sitting down and examining it with care see that the required thing can be done in a different mode and it is done in that different mode by the knowledge which he has of his business he has not produced a new invention nor one substantially differing from the original, but if the inventive faculties are exercised to produce the change, then he has a right to the benefit of whatever he thus invents. There must be mind and inventive genius involved in the change and not mere skill of the workman to avoid the consequences of an infringement. To constitute an infringement the thing used by the defendant must be such as substantially to embody the plain-

tiff's mode of operation and thereby obtain the same kind of result as was produced by his invention. It is not necessary that the result should be precisely the same in degree, but it must be the same in kind. For instance, the shutting of one door instead of two is a difference in degree, but not in kind; the same function is performed. Keeping these general principles in mind, I hope you will find no difficulty in applying them to the present case. May's patent is really for a method unknown before of bolting prison doors
89 without coming in contact with prisoners by a mechanical arrangement. To do this way is patentable, and he is to be considered as the original combiner of this mechanical arrangement so as to produce the intended result. In doing this he has used nothing new; nor is he required to do it. Bolts, bars, locks, levers, and pulleys are all old, but May has used them in such a way that the jailer can control the prisoners by working the doors while remaining away from the prisoners. It is the working the doors so as to avoid the necessity of actual contact with the prisoners which is the invention of May's. This is his idea, as he has carried it into successful practice. He is protected by law, and should be. If it were otherwise there would be no encouragement to inventive genius. Keeping in mind that May's invention is the ability of the jailer from the moment he enters the outer door to control the prisoners by bolting the doors while separated from them, the question arises, Does Hodson's apparatus infringe it? The difference between the two machines, which it is important for you to notice, consists in the different means used to fasten the doors. In both machines the apparatus used is to fasten the doors so as to control the prisoners without being under any apprehension from them. May complains that Hodson has appropriated his purpose and
90 arranged his machinery on the same principles, although the form has varied. The question of infringement is one for the jury.

The true point is, have the defendants used the invention of the plaintiff or something substantially like it? Do the two structures operate upon the same principles? Are they substantially the same? Did it require any invention to substitute the pulley for the lever or to fasten the first door horizontally instead of perpendicularly? If it did not they are mere change of forms to produce the same result, and the party using them in that way is an infringer. The operation of pulleys and levers *are* as old as society. Suppose a skilled mechanic should see May's invention, would he not at once know that the lever power in the pulley could serve the same purpose as the lever power in the lever? This is a question for your determination. May's invention secured to him not only the means but all other mechanical contrivances which are equivalent. It is well known to all intelligent men that the pulleys and weight can be used to produce the same result as the lever and bar. Did it require any exercise of invention to substitute the pulley for the lever or the bolt horizontal for the bolt perpendicular? Would or not any good mechanic at once see that their substitution could be
91 used to produce the same effect? If so, Hodson has appro-

priated May's invention and must respond in damages. It is for you, from the evidence, to say whether he has or not You have heard the evidence and must decide what witnesses to believe or disbelieve. I regret that the witnesses in this case have not, by their opinions on this subject, been able to lighten your labors, but I think after all that the case will not give you a great deal of trouble. If you find for the plaintiff you will find four hundred dollars.

UNITED STATES OF AMERICA, *District of Indiana,* } *ss:*

I, Noble C. Butler, clerk of the circuit court of the United States for the district of Indiana, do hereby certify that the foregoing is a full, true, and complete transcript of the record in the cause of Edwin May *vs.* The Board of Commissioners of Johnson County, Indiana, in said court as fully as the same appears of record and remains on file in my office.

Seal of Court. Witness my hand and the seal of said court, at Indianapolis, in said district, this 23rd day of December, A. D. 1886.

NOBLE C. BUTLER, *Clerk.*

92 DISTRICT OF INDIANA:

I, William A. Woods, judge of the district court of the United States for said district, do certify that at the date of the foregoing certificate Noble C. Butler was and now is the clerk of the circuit court of the United States for said district, and that his attestation aforesaid is in due form of law.

Witness my hand this 23rd day of December, 1886.

WM. A. WOODS, *Judge.*

EX. 1, DEF'T.

Circuit Court of the United States for the Western District of Wisconsin.

SARAH MAY, Plaintiff,
vs.
JUNEAU COUNTY, Def't.

It is hereby stipulated and agreed in lieu of the oral testimony of Chas. F. Cutler, to be given on the trial of this action, that the said Cutler will testify in substance that he has been clerk of the county board of supervisors of the defendant county and county
93 clerk of said county ever since the county was organized; that he was such county clerk when the public county jail of said county was built and from the time of the passage of the resolution therefor by the county board until the same was completed; that he never knew or heard until on or about the 21st day of July, A. D. 1885, that there had been put into the said jail a lock substantially the same as the patent claimed by the plaintiff in this action,

or that there was any patent on the lock of locks in use in said jail, or that the same infringed any patent, or that it was claimed or asserted by any person that any such infringement existed; that he was informed in a letter from G. W. Hazelton, Esq., attorney for the plaintiff, in said letter of July 21st, 1885, that he, the said Hazelton, was informed that the defendant was using the May patent in its jail to secure the doors of the cells; that he will further testify that the fact of the use of said patent or any patent, or that any infringement was claimed or asserted by or on the part of said county or its officers or servants in its jail, was never brought before the county board of supervisors of the defendant county in or by any resolution, motion, or in any other way until the session of said board in November, A. D. 1886; that said Cutler will further testify
94 that said jail was first occupied and used by the county or its officers on or about the first day of Jan., 1879.

This stipulation may be used upon the trial in the same manner as if the said Cutler had testified to the same matters on the trial of this action, subject to any objection on the ground that the same or any part thereof is incompetent or immaterial.

It is further agreed that the records of the county board of supervisors in relation to the building and accepting of said jail, so far as material, may be offered and used in evidence without being first produced or identified by said Cutler, and that the original contract for the construction of said jail, dated June 21, 1878, between said county and Thomas P. Cameron, Wilber A. Sykes, and Eugene Sykes, signed by them and by John Turner, T. P. Naughtin, and J. W. Tarbox, building committee of said county, may be offered in evidence, subject to objections as immaterial, without being produced or identified by said Cutler.

Dated Jan. 4, 1887.

G. W. HAZELTON,
Att'y or Pl'ff.
J. J. HUGHES,
Att'y for Def't.

95 DEF'T'S EX. 2.

WESTERN DISTRICT OF WIS.:

In U. S. Circuit Court.

SARAH MAY
vs.
JUNEAU COUNTY.

It is hereby stipulated and agreed that prior to Oct. 4, 1859, a device or contrivance was in use at the State prison at Waupun, Wisconsin, and elsewhere for fastening a series or row of cell doors by means of a lever and horizontal bar, but not operated outside of a corridor or partition separating the prisoners from the jailers. The object of this stipulation is to avoid the necessity of introducing on the trial of this action any evidence of the exact or particular con-

trivance in use in Waupun or elsewhere prior to the patent of the plaintiff.

Dated Dec. 22, 1886.

G. W. HAZELTON,
Pl'ff's Att'y.
J. J. HUGHES,
Def't's Att'y.

[Endorsed:] Copy of stipulation to proof. May *vs.* Juneau Co.

96 EXHIBIT 3.

Building Contract.

This agreement, made this 21st day of June, A. D. 1878, by and between Thomas P. Cameron, W. A. Sykes, and A. E. Sykes, of Manston, Wisconsin, of the first part, and the county of Juneau, by John Turner, T. P. Naughton, J. W. Tarbox, Thos. Weston, and E. Hart, a committee appointed for that purpose, party of the second part, witnesseth:

That the parties of the first part, in consideration of the agreements herein contained by the party of the second part to be performed and fulfilled, hereby agree to and with the party of the second part to erect, construct, and complete all stone, brick, wood, iron, other parts of and for a brick building designed for a county jail and jailer's residence, to be erected and constructed upon the following-described parcel of land, situate, lying, and being in the county of Juneau and State of Wisconsin, and known and designated as the county jail lot, in the village of Manston, Juneau county, Wisconsin, and to furnish all necessary materials for the same; said work to be done in a substantial and good, workmanlike manner, and said materials to be of best quality of their several kinds, and

97 in accordance with the plans and specifications for said buildings, of even date herewith and signed by the parties hereto and hereby made a part of this contract, and to the acceptance of H. C. Koch, architect, who is hereby declared to be the superintendent of said building, on or before the fifteenth day of October, A. D. 1878.

Aud the party of the second part, in consideration of the several agreements herein contained by parties of the first part, — to pay to said parties of the first part for said work and material the sum of ten thousand nine hundred dollars ($10,900.00) as follows: In monthly installments, to the value of said work as the same shall be done and furnished upon the certified estimates of the said architect and superintendent, less fifteen per cent. of the amount of each, such estimate to be retained and withheld until the completion and acceptance of said work and of furnishing of materials for the same.

It is mutually agreed by and between the parties hereto that all questions as to the quality of work done or materials furnished under this contract and as to the true intent and meaning of said plans and specifications shall be referred to and decided by the

building committee appointed by said county or said archi-
98 tect and superintendent without reference to any other person or persons, and that the parties hereto shall submit to and abide by their or his decision in the premises, and that all of said work shall be done and said materials furnished under their or his supervision and pursuant to his directions.

It is further mutually agreed by and between the parties hereto that in case any changes shall be made in said plans and specifications whereby the cost of doing said work or furnishing said materials shall be increased or diminished, of any extra work or materials furnished in the course of said job, such increase or diminution and such extra work or materials shall be estimated and valued upon the basis of the price hereinbefore fixed, and no such change of plans or specifications or extra work or materials shall operate to extend the time hereinbefore fixed for the completion of said work and the furnishing of said materials, unless such extension of time shall be expressly agreed upon by and between the parties hereto.

In presence of—

——— ———.

It is further mutually agreed by and between the parties
99 hereto that the inside blinds and the work connected therewith, as mentioned in said specifications, are to be omitted; also that the tin roof on the residence part of said building, as mentioned in said specifications, is to be omitted and shingles of the best quality substituted therefor; also that the galvanized-iron main cornice, as mentioned in said specifications, is to be omitted and wood cornice substituted therefor, and also that the ceiling of the lower tier of cells, ⅛-inch boiler plate, is to be omitted.

THOS. P. CAMERON.
WILBER A. SYKES.
EUGENE SYKES.
JNO. TURNER.
JUNEAU CO.,
By T. P. NAUGHTIER,
J. W. TARBOX,
Building Committee.

EXHIBIT 4.

Articles of agreement made and concluded this twelfth day of July, A. D. 1878, between Thomas P. Cameron, Wilber A. Sykes, and A. Eugene Sykes, of Manston, Juneau county, Wisconsin, parties of the first part, and the Manston Plow and Iron Works, of the same place, by B. M. Carter, manager, party of the second part.

The said party of the second part, for the consideration
100 hereinafter mentioned, does, for himself, his heirs and executors and administrators and assigns, — that he shall and will, on or before the fifteenth day of October next, after the

date thereof, furnish, manufacture, and place in position all the iron-work required to be used in the erection and completion of the Juneau county jail in accordance with the plans and specifications now on file in the office of the county clerk of said county under the head of iron-work, said work to be fully completed by the said fifteenth day of October, 1878, next.

In consideration whereof the said parties of the first part do, for themselves, their executors and administrators, covenant with the said party of the second part, his executors, administrators, and assigns, well and truly to pay unto the said party of the second part, his executors, administrators, and assigns, the sum of two thousand eight hundred and seventy-five dollars, which amount is to be paid as follows: Eighty-five per cent. of the estimate by the supervising architect of the amount of iron-work done to be paid to said party of the second part by the said parties of the first part when each estimate is made, and the remaining fifteen per cent. to be paid when the jail is completed and the same is accepted by the
101 "building committee" appointed by the county board of supervisors of Juneau county.

And for the performance of all and every the articles and agreements above mentioned the said parties do hereby bind themselves, their executors, administrators, and assigns, each to the other.

In testimony whereof the said parties have hereto interchangeably set their hands and seals the day and year first above written.

THOS. P. CAMERON. [SEAL.]
WILBER A. SYKES. [SEAL.]
A. EUGENE SYKES. [SEAL.]
MANSTON PLOW AND IRON WORKS, [SEAL.]
By B. M. CARTER, *Manager*.

In presence of—
CHAS. N. HOLDEN.

102 Circuit Court of the United States, Western District of Wisconsin.

SARAH MAY.
vs.
THE COUNTY OF JUNEAU.

Know all men by these presents that we, Sarah May and Joseph R. Dunlop, of the city of Chicago, in the State of Illinois, and Gerry W. Hazelton, of the city of Milwaukee, in the State of Wisconsin, are held and firmly bound unto the above-named county of Juneau in the sum of five hundred dollars, to be paid to the said county of Juneau; to which payment, well and truly to be made, we bind ourselves and each of us, jointly and severally, and our and each of our heirs, executors, and administrators, firmly by the presents.

Signed and sealed and dated the 3rd day of May, A. D. 1887.

Whereas the above-named plaintiff, Sarah May, is about to prosecute a writ of error to the Supreme Court of the United States to

recover the judgment rendered in the above-entitled suit by the circuit court of the United States for the western district of Wis-
103 consin in favor of the said defendant and against the said plaintiff:

Now, therefore, the condition of this obligation is such that if the said plaintiff, Sarah May, shall prosecute her said writ of error to effect and answer all damages and costs if she fail to make her plea good, then this obligation shall be void; otherwise the same shall be and remain in full force and virtue.

SARAH MAY. [SEAL.]
JOSEPH R. DUNLOP. [SEAL.]
GERRY W. HAZELTON. [SEAL.]

STATE OF ILLINOIS, }
County of Cook. }

We, Sarah May and Joseph R. Dunlop, above named, being duly sworn, severally depose and say that we are each of us worth the sum of one thousand dollars over and above all our indetedness and property exempt from execution.

SARAH MAY.
JOSEPH R. DUNLOP.

Subscribed and sworn to before me this 3rd day of May, 1887.
PHILIP A. HOYNE,
U. S. Commissioner, N. D. Ill.

104 MILWAUKEE COUNTY, *ss:*

Gerry W. Hazelton, above named, being duly sworn, says he is worth the sum of one thousand dollars over and above all his liabilities and property exempt from execution.

GERRY W. HAZELTON.

Subscribed and sworn to before me this 7th day of May, 1887.
FR. BLOODGOOD,
Commissioner Circuit Court U. S.

Bond approved this 9th day of May, A. D. 1887.
R. BUNN,
Dist. Judge.

105 [Endorsed:] Bond on writ of error. Filed May 9, 1887. F. M. Stewart, cl'k.

106 UNITED STATES OF AMERICA, }
Western District of Wisconsin, } *ss:*

I, F. M. Stewart, clerk of the circuit court of the United States of America for the western district of Wisconsin, do hereby certify that I have compared the writings annexed to this certificate with the originals now in my custody and they are true copies of their respective originals and are correct transcripts therefrom and of the whole thereof now on file and remaining of record in my office and the

original writ of error and citation on writ and copy of bond on appeal.

Seal U. S. Circuit Court, Western Dist. of Wisconsin.

In testimony whereof I have hereunto set my hand and duly affixed the seal of the said court, at the city of Madison, in the said western district of Wisconsin, this 6th day of August, in the year of our Lord one thousand eight hundred and eighty-seven, and of the Independence of the said United States the one hundred and twelfth.

F. M. STEWART, *Clerk.*

107 In the Supreme Court United States.

UNITED STATES OF AMERICA, *ss:*

To Juneau County:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, to be holden at Washington on the second Monday of October next, pursuant to a writ of errer filed in the office of the clerk of the circuit court of the United States for the western district of Wisconsin, wherein Sarah May is plaintiff and you are defendant in error, to show cause, if any there be, why the said judgment in the said writ of error mentioned should not be corrected and speedy justice should not be done to all parties in that behalf.

Witness the Hon. Romanzo Bunn, judge of the district court of the United States for the western district of Wisconsin, this 9th day of May, A. D. 1887, and of our Independence the 111th year.

R. BUNN, *Judge.*

108 [Endorsed:] Supreme Court U. S. Sarah May, pl'ff in error, *vs.* Juneau County, d'f't in error. Citation. Service hereof admitted this 9th day of Aug't, 1887. J. J. Hughes, Pinney & Sanborn, att'ys for d'f't in error.

Endorsed on cover: W. Wisconsin C. C. U. S. No. 94. Sarah May, plaintiff in error, *vs.* The County of Juneau. Filed September 2, 1887.

Office Supreme Court, U. S.
FILED
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JAMES H. MCKENNEY
CLERK

THE SUPREME COURT

OF THE UNITED STATES.

OCTOBER TERM, 1890.

NO. 94.

SARAH MAY,
Plaintiff in Error,

vs.

THE COUNTY OF JUNEAU,
Defendant in Error.

In Error to the Circuit Court of the United States for the Western District of Wisconsin.

BRIEF FOR PLAINTIFF IN ERROR.

M. C. BURCH,
Aram E Fox *Of Counsel for Plaintiff in Error.*

GRAND RAPIDS, MICHIGAN:
W. W. HART'S ARCADE STEAM BOOK AND JOB PRINTING HOUSE.
1890.

THE SUPREME COURT

OF THE UNITED STATES.

SARAH MAY,
Plaintiff in Error,
vs.
THE COUNTY OF JUNEAU,
Defendant in Error.

STATEMENT OF FACTS.

The Plaintiff, who was a resident of Chicago, Illinois, brought suit in the Western District of Wisconsin, to recover damages alleged to have accrued to her as assignee of Patent No. 25,662, issued to Edwin May, of Indianapolis, Indiana, October 4th, 1859, for an improvement in the construction of prisons, which patent was renewed for seven years October 4th, 1873, and which expired October 4th, 1880. The patent had expired at the time the assignment was made, and the patentee had died, and the assignment was made to his widow some time after his death, by George T. McGinnis, administra-

tor *de bonis non* of the patentee's estate. It is claimed that the assignment from McGinnis to the Plaintiff herein, who was the widow of the patentee, conveyed to the Plaintiff the Chose in Action, or in other words the right to bring suit in this case.

The case came on to be heard in the Western District of Wisconsin, at Madison, Wisconsin, before his Honor Judge Bunn, of the Western District of Wisconsin. The Plaintiff made a *prima facie* case and rested, and the Defendant, after introducing certain testimony, not important to be considered, asked the Court to take the case from the jury, on these grounds, substantially:

FIRST. That the Plaintiff had no right to commence proceedings in this case, for the reason that the assignment of the administrator to her, did not cover past infringements.

SECOND. Because a County could not be held liable for the infringement of a patent.

And after argument the Court adopted the positions taken by Counsel for Defendant County, and directed a verdict for Defendant, to which the Plaintiff duly excepted, and upon which rulings the case was brought to this Court on writ of Error.

The questions raised in this case are identical with a part of those raised in the case of *Fond Du Lac vs. May, No. 61*, on the Calender for this term of this Court, and for all practical purposes the position taken by us in that case, might be adopted in this one, but as the rule requires it, and Counsel in this case are not bound to take notice of the brief

filed by us in that case, we deem it proper to file a short argument herein.

FIRST.

The question of Mrs. May's right to bring suit for past infringement, is one which must depend upon the construction of certain language in the contract of conveyance, between George T. McGinnis, the Administrator, and Mrs. May.

The circumstances briefly stated as shown by the record are these: May, the patentee, who had taken out qnite a considerable number of patents at an early date, but apparently realized little or nothing from them, as is common in the history of most inventors, died absolutely insolvent, that is to say, there was not enough of his estate, as appears from the record, to pay for the expenses of administration and pay his creditors the amount of their claims. He left a widow penniless, and after struggling with the insolvent estate for a time, his son, Edwin Forrest May, seems to abandon the situation, and it was then turned over by the Court to Gen. McGinnis, who, administrating, found it necessary to report to the Court that the property of the estate had been sold, and the proceeds distributed, except the rights of Defendant in certain letters patent, which had not been disposed of, and that there was a favorable opportunity for selling such rights; that it was proper in his judgment to sell them at private sale. While we are not at liberty to inquire into the motives of Gen. McGinnis in this transaction, it may be perfectly fair as a matter of argument, to

assume, that in these patent rights he recognized the only thing that could be of service to the widow of the deceased inventor, thus left to fight her way in the world alone, and that he took the shortest and best legal method known to him as a lawyer, to convey them and everything appertaining to them, into their hands. It would be idle for an administrator to attempt to make anything out of patent rights, especially if they were of no particular importance or value, as undoubtedly was the case with all others except this particular one. Whatever could be realized from them, must be the result of personal efforts of some one actually interested in turning them to the best account possible. It was the decent, equitable, and proper thing to do; undoubtedly was understood by both the administrator and the Court, to give Mrs. May the benefit of whatever there was in them, and no amount of argument will serve to dispose the mind of a Court, acting without prejudice, against the conveyance in question, simply because the consideration therefor was small. It might do to influence a rural jury, but even there the argument might be fairly and forcibly made, that under the peculiar circumstances in this case, the consideration of $15 cut no figure in the case.

It is subject in which the Defendant is not in the slightest degree interested, except as the possibility might arise that they would be obliged to pay a second time to the representatives of the estate, a thing which the administrator and the Court plainly intended should never occur. It may be argued, as

it was before the Circuit Judge, and evidently with some effect, that the other patents in the case were the valuable ones, and that this was mentioned as a mere matter of formality, it having expired, but it is just as fair to argue that the others counted for nothing, as was the fact, and that this particular patent was all that there was of value in the transfer. That which is of record may be noticed by the Court, and although the other patents were *in ease*, nothing has ever been heard from them in the Courts, while the snits upon this particular patent are largely noticed in the Federal Reporter for some years past, with one unvarying result, except in this particular case, where Judge Bunn relieved the jury of any responsibility. It may be also a significant fact, that although these cases have been before the Court for now several years, and have come to be of wide reputation, it does not appear to be reported anywhere that Gen. McGinnis, or any person interested in the estate, has anywhere appeared to claim rights adverse to Mrs. May.

We venture to offer the suggestion, therefore, that so far as this Defendant is concerned, or any Defendant in these cases, any such representatives of the estate are estopped by the open, public, widely public, action of Mrs. May in prosecuting these suits in her individual name and capacity as assignee. Everything which surrounds the case, so far as outside circumstances are concerned, point unerringly to the fact that Mrs. May is, and was intended to be, sole owner of the rights of action, which had accrued to her deceased husband during

his lifetime, up till the expiration of the patent; that so far as this County was concerned, or any Defendant in a similar case is concerned, they have a perfect defense to any subsequent action, which could possibly be brought by parties not in the records of the Court, merely for Marion County, Indiana, but for the reasons just before stated.

The point raised then by Defendant is technical rather than substantial, as eventually the County could be held to respond in damages to some one, if not to the Plaintiff in this case. It is argued on the part of the defense, or was on the trial below, that the scope of the petition for right to sell, filed by the Administrator with the Court of Marion County, was too narrow to admit of the sale of rights for past infringements; but this argument is specious and unreal, for the administrator recites that everything has been sold which appertained to the estate, and the proceeds, except these rights. If he had not intended to convey, or to ask for a license to convey, everything remaining to the estate, he certainly would have specifically mentioned the rights to sue for infringement, as well as to sell the right to the patent. Of course it would have been an absurdity to have asked specifically to sell the right to this particular patent, which was not *in esse*, having expired a long time previous, and by fair construction he did ask the privilege to sell any rights appertaining to this patent, and the Court must be presumed either to have been ignorant of that which was before him for action, or not to have fully understood the effect of that which was

asked, viz: to close out the estate. And after granting such license, the record shows that the deed in question particularly recited this patent, the date of its issue, and the date of its extension. Now the Administrator knew, is presumed to have known, that this patent would have expired October 4th, 1873. If it had not been extended, and the extension did expire October 4th, 1880, and the record shows, that after having carefully examined the deed of conveyance to this Plaintiff, the same was duly approved by the Court. Upon well settled principle so common as to need no citation of authorities or cases, after such action, when no one directly interested to any possible extent raises the question, another Court will not listen to it where raised by uninterested parties in a collateral way.

In May vs. Mercer County, 30th Fed. Rep. 246, the Court very aptly states on page 250, "The Marion Circuit Court of Indiana, had jurisdiction of the subject matter, that is, the estate of Edwin May, and it is a Court of general jurisdiction, and that Court has confirmed the sale of this right of action, hence this Court will not attempt to revise that judgment, and declare that by the Statutes of Indiana that Court could not legally sell such estate, or that the order given by that Court was not broad enough to include this *chose in action*. That Court has construed its own order by confirming the sale, and this Court will not attempt to revise it."

The learned Judge there stated, it seems to us, in a nut shell, the well settled principles of law applicable. Upon this same point the learned Judge of the 6th

Circuit, in *May vs. The County of Logan, 30 Fed. Rep.* upon pp. 253, 254 and 255, very carefully reviews the situation and passes upon the same question, citing numerous authorities of this and other Courts in support thereof. The only dissenting opinion in all the line of these cases, from the general current of decisions, was in this case below, and they were made upon the authority of *Moore vs. Marsh, 7th of Wallace, 515*, and *Dibble vs. Auger, 7th of Blatchford, 86*. That the decision in those cases seem not to have been fully apprehended, or even carefully considered by the learned Judge in this case, is clearly demonstrated by the Circuit Court for the Eastern District of Michigan, in the case of *May vs. Saginaw County*, Judge Brown of Detroit presiding, which case is reported in the 32d Federal Reporter, 659. In *Moore vs. Marsh*, where the patent was yet alive, the language was not so broad or so comprehensive as this, and where there appeared to be no intention upon the part of the grantor to assign any right to bring action for past infringements, it was simply held that he did not assign such right, and as Judge Brown aptly remarks, "It is strange that it should ever be contended that he did." In the case of *Dibble vs. Augur*, the facts in the case were so different from those in the case at bar, that it could hardly be considered analogous. Counsel will not here attempt a discussion of the case, since that of Judge Brown, in *May vs. Saginaw County*, has left but little to say upon the subject. It does not seem as if there could be serious doubt as to the error of the District Judge, in that particular in this case.

The next question to be considered, is that of *ultra vires*. And here again the question has been very fully considered at Circuit in the cases heretofore stated. The history, we think, of this line of cases, since they are matters of common report in legal publications, may be properly traced. Judge Bunn in this case on demurrer, first held against them *pro forma*. In the next instance, Judge Dyer, in *May vs. the County of Fond Du Lac*, passed upon the question favorable to us, as appears from the record in that case now before this Court, although his language is not given. In doing so, he but followed the views of Justice David Davis, in *May vs. The Commissioners of Johnson County*, District of Indiana, in 1872. This case is not reported, but we produce with this brief a certified copy of the charge of Judge Davis to the jury. Judge Bunn, upon the trial of this case held against us, as appears from the record, but about the same time, in the cases of *May vs. Logan and Seneca Counties*, Judge Jackson, after careful research, held to the opposite view. Later on, in the same volume of the Federal Reporter, Jude Barr, of the District of Kentucky, held with us. Again, Judge Thayer, in the *31st Federal Reporter, in May vs. the Counties of Ralls, Jefferson and St. Genevieve*, tried in the Eastern District of Missouri, held the same way. Judge Leavett had before made an adverse holding in the case of *Jacobs vs. Hamilton County*, a case as we think very hastily decided upon an entirely erroneous view of the case of *Mighels vs. Com'rs, 7th Ohio State, 110*. In the Mighels case, the plaintiff on a dark night fell through an unprotected stair-

way of the Hamilton County Court House and was injured. The Supreme Court of Ohio held, that the County was only a legal division of the State for governmental purposes, and that the County or tax-payers were not liable for neglect in such a case. Upon the strength of that opinion, which was eminently correct, Judge Leavett reached the conclusion that a County could not be held liable for the infringement of a patent, and Judge Bunn adopted that view.

The question is so plain and so squarely stated, that extensive argument does not seem to be necessary, and as the time for the preparation of this brief is very limited, we do not think it necessary or proper to cite authorities or further discuss the point.

We think the learned Judge below erred also in this respect, in directing a verdict for the Defendant, and that a new trial should be granted by this Court.

M. C. BURCH, Duane E Fly
Of Counsel for Plaintiff in Error.

ED STATES

SUPREME COURT OF THE UNITED STA.

No. 94.

OCTOBER TERM, 1890.

SARAH MAY, *Plaintiff in Error*,

vs.

JUNEAU COUNTY, *Defendant in Error.*

Brief for Defendant in Error.

S. U. PINNEY,

Attorney for Defendant in Error.

JOURNAL PRINTING CO., PRINTERS AND STEREOTYPERS, MADISON, WIS.

SUPREME COURT OF THE UNITED STATES

No. 94.

OCTOBER TERM, 1890.

SARAH MAY, *Plaintiff in Error*,

vs.

JUNEAU COUNTY, *Defendant in Error*.

STATEMENT OF FACTS.

This case is the same, in its general features, as *Fond du Lac County vs. May*, being No. 61 of this term.

The plaintiff in error commenced this action on the case September 23, 1885, for an alleged infringement of a patent granted to Edwin May, October 4, 1859, for fourteen years, and duly extended to October 4, 1880. P. Rec., 5, 17–19.

The infringement alleged in the complaint is that the defendant in error "did make and use, and caused to be made and used," certain specimens of the device in question. P. Rec., 4. The infringement claimed to be shown in proof consists only in the alleged use of an old device, consisting of a lever and bar operated on the outside of a jail corridor, instead of the inside. The use of the lever and bar on the inside of the corridor would be lawful, as they are ancient contrivances: but it is claimed that the extension of the bar through the corridor, and the use of the lever on the outer

wall, being thus done with greater security to the jailor, and less opportunity of escape to the prisoners, is patentable as "a machine, a manufacture, a composition of matter or an art."

The facts shown by the record are that Juneau county, through a building committee of its board of supervisors, made a building contract for the erection of a county jail with Cameron & Sykes June 21, 1878. The contractors were to furnish all the materials and complete the building by October 15, 1879, according to certain plans and specifications. P. Rec., 41. The specifications contained the following provision as to the May patent:

"The cell doors are locked by a wrought iron shut-bar working on two staples for each door, . . . these bars on lower tier of cells extend to outside face of corridor enclosure, with quarter-inch thick bolts riveted on the face to secure the bar handle, the handle to be in the form of a lever, secured on the bottom with a Scandinavian lock. The shut or lock bar for the upper tier of cells . . . to extend through the wall into the hallway and turnkey room, with a plate anchored to the wall, with the same kind and quality of lock for the handle." P. Rec., 8.

This is substantially the same as the fourth specification of the May patent. P. Rec., 18.

The original contractors, Cameron & Sykes, sub-let the iron work to one Carter, who put in the bar handle and lock described in the specifications without obtaining any license to use the device from the patentee. P. Rec., 14, 42, 43.

The county board of supervisors accepted the jail from the contractors January 1, 1879. None of its officers or agents knew of the alleged infringements, or ever heard, until July 21, 1885, that the contractor or subcontractor had

not obtained a license to use the patent. P. Rec., 9, 10, 15; O. Rec., 26, 41.

The patent expired October 4, 1880, about twenty-one months after the county took possession of the jail; "and since the said jail was completed with the said device for lock and unlocking the cell doors, there had been no occasion to use the same for locking prisoners in any of the cells, and that in fact since January 1, 1879, at which time said jail was first occupied and used by defendant, no prisoner requiring to be locked in his cell has been committed to or confined in said jail. P. Rec., 15; O Rec., 42.

The title of the plaintiff in error to the cause of action set up in the complaint is deduced as follows: Edwin May, the patentee, died testate February 27, 1880, after the alleged infringement, and before the expiration of the extended term of the patent. Letters testamentary were issued to Edwin F. May in May, 1880, who resigned his trust, and on June 7, 1880, letters of administration were issued to Geo. F. McGinnis. P. Rec., 19, 20. On December 31, 1881, the administrator made his petition to the court, stating that he had administered the estate "except the right of the decedent in certain letters patent from the United States of America, which have not been disposed of; that there now offers a favorable opportunity for selling such rights; that the same are of little value, and that your petitioner believes that it is for the best interest of the estate to sell said rights at private sale without appraisement or advertisement, saving the cost thereof." P. Rec., 22.

The court thereupon made the following order:

"That said administrator is now authorized and empowered by the court to sell said rights at private sale without advertisement or appraisement, and is ordered to report his doings at the next term of this court." P. Rec., 22, 23.

On March 7, 1882, the administrator made the following report:

"George F. McGinnis, administrator *de bonis non* of the estate of said decedent, Edwin May, presents the following report of his doings in respect to the order heretofore entered in this court authorizing said administrator to sell at private sale the rights of said estate in certain letters patent. This administrator made diligent efforts to secure bids for such rights, and on the 19th day of January 1882, Mrs. Sarah May did bid therefor the sum of fifteen dollars, and, that being the best offer the said administrator could procure, such rights were by this administrator sold to said Sarah May; and said Sarah May having paid said bid, this administrator executed to her a deed of assignment of such rights, which he now brings into court for approval." P. Rec., 23.

The deed of assignment recites that Edwin May, deceased, did during his lifetime obtain of the United States, certain letters patent for inventions and discoveries, as follows:

1st. The patent in suit in this case, dated October 4, 1859, and extended October 4, 1874, No. 25,662.

2d. Certain letters patent dated December 27, 1870, No. 110,483.

3rd. Letters patent dated June 28, 1870, No. 104,865.

4th. Letters patent dated May 4, 1869, No. 89,782.

5th. Letters patent dated January 26, 1869, No. 86, 312; and

6th. Certain letters patent dated April 30, 1869, No. 88,972.

That said administrator did on January 19, 1882, at private sale, sell all and singular the letters patent aforesaid, and all the right, title, interest, claim and demand of said estate in, to, by, under and through the same to Sarah May

for fifteen dollars ($15), that being the highest and best bid and offer for such rights.

Now, therefore, to all whom it may concern, be it known that for and in consideration of the said sum of fifteen dollars ($15) to me in hand paid, and in pursuance to the order and authority aforesaid, I, the said Geo. F. McGinnis, as administrator of the estate of said Edwin May, deceased, have sold, assigned, transferred and set over, and do hereby sell, assign, transfer and set over, unto the said Sarah May all the right, title, interest, claims and demands whatsoever, which the said estate of said Edwin May, deceased, has in, to, by, under and through the said improvements and the letters patent and extensions thereof therefor aforesaid; the same to be held and enjoyed by the said Sarah May for her own use and behoof and for the use and behoof of her legal representatives to the full end of the term for which said letters patent and extensions thereof are or may be granted, as fully and entirely as the same would have been held and enjoyed by said estate had this assignment and sale not been made, and as, by and under the order and authority aforesaid, I, as such administrator, can or ought to grant, sell and assign the same. P. Rec., 25, 26.

The defendant pleaded the general issue, the statute of limitations, the manner in which the improvement was placed in the jail of the county, and that it was not liable in this action on the ground that a county cannot be held liable for the wrong of its servants or officers; also that the alleged improvement was not patentable. P. Rec., 7, 8.

Upon the trial, and after the evidence was in, the court, on motion of the defendant, directed the jury to render a verdict for the defendant on the grounds: (1) That the defendant is merely a territorial division of the state, existing as a political subdivision thereof, and cannot be held liable for

the infringement of the patent; (2) that the right of action herein has never been assigned to the plaintiff.

Which motion was on both grounds sustained by the court. The jury thereupon being instructed in the law by the court rendered a verdict, in which they found for the defendant, under the direction of the court. Judgment was entered upon the verdict and for costs against plaintiff. P. Rec. 11, 16.

ARGUMENT.

The defendant in error insists:

First. That the alleged improvement in the construction of jails is not "a machine, a manufacture, a composition of matter or an art," and so is not patentable.

Second. That the defendant in error, being a county, is not liable for the alleged infringement.

Third. That the plaintiff has no title to the cause of action.

I.

It is claimed by the plaintiff in error that the first and fourth claims of the May patent are infringed by the construction of the defendant's jail. The first claim of the patent is an angle door; the fourth is the interposition between the jailer and the prisoners of a corridor through which the shut-bar which locks the cells runs, operated by a lever outside of such corridor.

But the angle door is an old device long and well known before the patent was taken out. The witness Moulton, for the plaintiff, testified on cross-examination as follows:

"I think an angle door is old; have never seen them in jails; have seen angle doors and curve doors and illustra-

tions of them in books many years before 1859." P. Rec., 14.

The essential point of the case in respect to the question of patentability is whether the extension of a lever attached to a bar, both of which lack novelty, through a corridor or wall so as to interpose between the prisoners and the jailer a space for his and their protection, can be made the subject of a patent. It is insisted on the part of the defendant in error that this is merely using an old device in a new situation without invention, and with the same mechanical operation. It is the same in substance as the use of a ladder upon a hotel for a fire-escape, or to use a long key to unlock a cell door through a grating. The operation and effect are precisely the same whether the lever and bar are operated outside or inside the grating or corridor. It is a mere lengthening of a bar.

Suppose, instead of lengthening the bar through the corridor, the patentee had sought a patent upon an arm-hole through the grating, so that the jailer could reach through into the corridor and work the lever and shut-bar; the same result would be thus accomplished; but it seems clear that the arm-hole in connection with the corridor grating and lever and bar, all being old, would not be patentable.

The use of an old method to produce new results is not the subject of a patent, as in the case of a peg used to keep the seat of a cornplanter from tipping.

The Cornplanter Case, 23 Wall., 232.
The Cupola Furnace Case, 104 U. S., 491.

It seems that an improvement in the construction of jails is not the subject of a patent, not being a machine, a manufacture, or a composition of matter or an art.

Jacobs v. Baker, 7 Wall., 259.

A result or effect is not patentable.

Carver v. Hyde, 16 Pet., 513.
New Process Fermentation Co. v. Maus, 20 Fed. Rep., 725.
Le Roy v. Tatham, 14 How., 156.
Case v. Brown, 2 Wall., 320.

Nor is a mere change in location, by putting an old device in a different position with regard to another old device.

Manufacturing Co. v. Ladd, 102 U. S., 408.

It is submitted that the use of the old device in question in a new position outside a space or corridor is a mere change of location, and is not an invention, and has no new mechanical effect, and that the law cannot take notice of the motive of the inventor or the new effect or result of the use of the old device.

Tucker v. Spaulding, 13 Wall., 453.
Brown v. Piper, 91 U. S., 37.
Burt v. Evory, 133 id., 349.
Hill v. Wooster, 132 id., 693.
Watson v. C., I., St. L. & C. R. Co., 132 id., 161.
Aron v. Manhattan R. Co., 132 id., 84.
St. Germain v. Brunswick, 135 id., 227.
Heald v. Rice, 104 U. S., 754.
Hall v. Macneale, 107 id., 90.
Thompson v. Boissellier, 114 id., 1.
Dunbar v. Meyers, 94 id., 187.
Stephenson v. Brooklyn C. T. R. R. Co., 114 id., 149.
Double-pointed Tack Co. v. Two Rivers Mfg. Co., 109 U. S., 117.
Pickering v. McCullough, 104 id., 318.
Hendy v. Golden State, etc., Works, 127 id., 370.
Forbush v. Cook, 2 Fisher, 669.

II.

The patent expired October 4, 1880. In 1878 the county, through a building committee of its board of supervisors, made a contract for the construction of a complete jail with a firm of builders, Cameron & Sykes. The latter sublet the iron work to one Carter, who caused to be put in the lever and bar alleged to be an infringement of the May patent. The specifications in the contract provided that such a lever and bar, which are almost precisely the same as those described in the specifications of the May patent, should be put in the jail. The county took possession of the jail January 1, 1879, *but made no use whatever of the lock in question down to the time of the trial in January, 1887.* O. Rec., 42.

None of the officers or agents of the county ever knew until long after the expiration of the patent that there had been any infringement, or that any infringement was claimed. P. Rec., 15, 39, 40.

Our contention now is that the county did not make or use the device in question, but that this was done by Carter, the subcontractor, and that it was Carter's duty, under the contract and specifications, to procure a license from the patentee, if the design was patentable, and the patent valid, as now assumed for the purpose of this argument. Certainly the county never used this device in any way, shape or manner. No prisoner requiring to be locked up in his cell was ever confined in the jail. The jailer of the county never made the slightest use of this improvement. It is submitted, therefore, that the defendant in error cannot be held liable for an infringement for *using* the device in suit.

Nor did the county make or manufacture the design in question. This was done by an independent contractor.

The force of the contract and specifications was that the contractor or subcontractor should pay for a license to put in the improvement.

This point was clearly ruled by the late MR. JUSTICE CLIFFORD in the case of *Lightner v. Brooks*, 2 Cliff., 287. In that case the plaintiff claimed an infringement of car boxes called "Lightner boxes." The defendant signed the contract with one Bradley to construct certain passenger cars with such "Lightner boxes." The contractor infringed Lightner's patent, and Lightner sued the defendant, alleging that by the contract in question he had authorized the infringement. It was held he was not liable. The court says:

"When the defendant in this case contracted that the cars should contain the improvement of the plaintiff, he did not command or authorize the contractor to infringe the patent of the plaintiff. . . The person contracting in this case was not the servant of the defendant. . . Where parties contract for implements, machines or structures without any knowledge that the contractor is an infringer or intends to use an improvement without authority, it is not the just and legal implication from the contract that the party ordering the articles contemplates that the contractor will violate the rights of the patentee, or that he thereby commands or directs an infringement. Such contracts are now of daily occurrence; and unless there is some proof of concert, or something in the terms of the contract to indicate a contrary intent, the presumption must be that the person ordering the article either supposed that the contractor had the right to use the improvement, or, as part of the price to be paid by the purchaser of the article ordered, would procure the right of use from some person authorized to grant it for that purpose."

Clearly, therefore, as it is submitted, the county never made or used the improvement in question. This was done by a subcontractor, who failed to obtain a license from the patentee.

The county merely purchased a completed jail. The lock in question was in the jail, but was a part of it. The county did not purchase a lock, but purchased a jail.

Suppose a person buys a house containing a patent device for the supply of water, but makes no use whatever of it; suppose again he buys a house into which a contractor has built patent brick; he buys a house, not brick, and, of course, cannot be held liable for infringement. The county has used the jail as real estate, though it has never used the improvement in question. The materials in the improvement clearly belonged to the contractor, and the title passed to the county inasmuch as the alleged patented improvement did not add any new material, but simply changed the position or location of an old device; the principal object or effect of the use of the device was all that had any existence; and as there was no use of the device by the county, and as it got no benefit whatever from the device in question, it should not be held liable for infringement.

But we contend that the county cannot in any event be held liable for the infringement of the patent by its officers or agents. As said by MR. JUSTICE CLIFFORD in the case of *Laramie County v. Albany County*, 92 U. S., 307, 311: "Public duties are required of counties as well as of towns, as a part of the machinery of the state; and in order that they may be able to perform those duties they are vested with certain corporate powers, but their functions are wholly of a public nature.

* * * * * * * *

"They are but subdivisions of the state, deriving even

their existence from the legislature. Their officers are nothing more than local agents of the state."

A county is not liable for the misfeasance or nonfeasance of its officers, agents or servants when pursuing its public duty. A county is a political division of the state, and is no more liable for the tortious acts or negligence of its officers or agents than the state would be in the absence of a statute imposing this liability.

Gilman v. Contra Costa Co., 68 Am. Dec., 294.
Commissioners v. Mighels, 7 Ohio St., 109, 118.
Commonwealth v. Brice, 22 Pa. St., 211.
Lorillard v. Monroe, 11 N. Y., 392.
People ex rel. v. Auditors, 74 N. Y., 311.
Kincaid v. Hardin Co., 53 Iowa, 430.
House v. Commonwealth, 60 Ind., 580.
Hollenbeck v. Winnebago Co., 95 Ill., 148.
Hill v. Boston, 122 Mass., 344.
Mehr v. Gauge Co., 5 Neb., 494.

A county is not liable for the infringement of a patent upon the same rule of exemption.

Jacobs v. Commissioners, 1 Bond, 500.

III.

The plaintiff is not the owner of the cause of action alleged in the complaint, if any such exists, and the county should not be held liable for infringement.

The proceedings in the probate court for the assignment of this, with five other patents, are fully set out in the statement of facts; six patents altogether are described in the proceedings. One of these patents, being the one in suit here, had expired when this assignment was made, but the whole was sold for $15.

The operative words of conveyance are: "All the right,

title and interest, claims and demands whatsoever which the said estate of said Edwin May, deceased, has in, under, by and through said improvements and the letters patent and extensions thereof therefor aforesaid."

The question here presented arose in *Dibble v. Augur*, 7 Blatch., 87. The court say: "By the naked assignment Robertson did not transfer to Dibble his claims for past infringements of the patent. There are no words therein looking to the past. The language is wholly future in its scope. In conveying all of Robertson's 'right, title, interest, claim or demand whatsoever in, to or under' the patent, it conveys only the right to claims for infringements which should be committed after such assignment. The words 'claim or demand whatsoever in, to or under' the patent are not sufficient to cover claims for past infringements."

Moore v. Marsh, 7 Wall., 515.

Kaolatype Engraving Co. v. Hoke, 30 Fed. Rep., 444.

The language used in this assignment is, we contend, wholly inoperative to convey the right to past infringements. Suppose a person is the owner of a cause of action for trespass to land which accrued before his conveyance of the land to another; suppose he desires to convey the cause of action for trespass, and in order to do so makes a second conveyance of the land. It could hardly be contended that such a conveyance would pass the cause of action. The administrator of Edwin May did not use apt words to convey the causes of action for previous infringements, and he is still the owner of them.

It is submitted that the judgment of the circuit court should be affirmed.

S. U. PINNEY,

Attorney for Defendant in Error.